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IN THE

Supreme Court of the United States

No. 608.

October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

v.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

Brief for Petitioner.

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IN THE
Supreme Court of the United States.

No. 608. October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

BRIEF FOR PETITIONER.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

This is a suit for the alleged "*contributory*" infringement of Butler patent No. 1,593,791. The suit is before this Court on a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit. (302 U. S. .)

The Circuit Court of Appeals held that the sale by petitioner of an old grease-cup, constituted "*contributory*" infringement of the patent in suit, even though the patent in suit is based upon an alleged improvement in an entirely different device, to wit, an alleged improvement in a coupler. The patent in suit, while based upon an alleged improvement in the internal construction or mechanism of a coupler, claims the allegedly improved coupler in so-called "*combination*" with the old grease-cup and the old pump with which the allegedly improved coupler is intended to be used.

Petitioner is **not** charged with having manufactured or sold **any** couplers (or pumps) in infringement of the patent in suit.

The Circuit Court of Appeals held that the sale by petitioner of an **old** grease-cup *for use with* an allegedly improved coupler (and an **old** pump) made by respondent assertedly in accordance with its Butler patent in suit, constituted "*contributory*" infringement of the patent. In this holding, the decision of the Circuit Court of Appeals is irreconcilably in conflict with the decision of this Court on Gullborg claims 1 to 10 in the recent case of Rogers v. Alemite (298 U. S. 415).

The Circuit Court of Appeals also held that, while Butler's allegedly improved coupler construction is barely distinguishable from the coupler constructions of the prior-art, the coupler-part of Butler's claim-language may nevertheless be given a broad enough interpretation to cover the specifically **different** coupler construction of respondent's commercial Alemite *HYDRAULIC* coupler (with which petitioner's grease-cup is charged "*contributorily*" to infringe). In this holding, the decision of the Circuit Court of Appeals is in direct conflict with the decision of the Court of Appeals for the Eighth Circuit in the case of Stewart-Warner Corp. v. Jiffy Lubricator Co. (81 Fed. 2d, 786;—certiorari denied 299 U. S. 554) as to the scope of Butler's coupler invention.

OPINIONS OF THE COURTS BELOW.

The opinion of the Circuit Court of Appeals for the Seventh Circuit on the appeal in the case at bar, is reported at 91 Fed 2d 757 (and is also in the Transcript of Record herein on pages 638 to 644). The order of said Court on the petition for rehearing is unreported but is reproduced in the Transcript of Record herein (R p 719).

The opinion of the District Court is reported at 15 F. Supp. 571, and is also reproduced in the Transcript of the Record herein on pages 603 to 620, inclusive.

Subsequently, the District Court also filed a second opinion on the denial of defendant's petition for rehearing in the trial court. This second opinion is reported at 16 F. Supp. 788. As defendant took no appeal therefrom, and as indeed no appeal lies from such denial of the petition for rehearing, the Transcript of Record before the Court of Appeals for the Seventh Circuit and likewise the Transcript of Record filed herewith, contains

neither the additional and newly discovered evidence which formed the basis, *inter alia*, of defendant's petition for rehearing in the trial Court,
nor the opinion of the trial Court denying such petition for rehearing.

Likewise, the Transcript of Record does not include the further oral statements of the trial Court on the denial of defendant's motion for supersedeas, as defendant took no appeal from such denial of supersedeas. These latter oral remarks of the trial Court are not reported in the Federal Reporter system, although they are reported at 31 U. S. P. Q. 193.

JURISDICTION.

The grounds on which the jurisdiction of this Court is invoked, are:

1. The date of the judgment to be reviewed was June 29, 1937 (R p 645 for the judgment and R p 628-644 for the opinion). Petitioner duly filed a timely petition for rehearing in the Circuit Court of Appeals (R pp 647-178), but the same was denied. The date of the order denying the petition for rehearing is September 15th, 1937.

2. The judgment was rendered in a suit in equity brought under the patent statutes to determine the issues of validity and infringement of letters patent for invention issued by virtue of Sec. 4886 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 31).

3. The statute under which jurisdiction is invoked is Sec. 240 (A) of the Judicial Code (U. S. C. Title 28, Sec. 347), as amended by the Act of February 13, 1935.

4. Cases sustaining jurisdiction are:—

Gypsy Oil Co. v. Escoe, 275 U. S. 498

(on timeliness of petition for writ of certiorari);

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429;

Rogers v. Alemite, 298 U. S. 415;

Bassick v. Hollingshead, 298 U. S. 415

(conflict as to scope or infringement of same patent);

Concrete Appliances Co. v. Gomery, 269 U. S. 177

(conflict as to validity of same patent);

Alexander Milburn v. Davis-Bournonville, 270 U. S. 390

(conflict on same question of patent law);

Carbice v. American Patents Development, 283 U. S. 27;

Adams Grease Gun Corp. v. Bassick Mfg. Co., 285 U. S. 531;

Rogers v. Alemite, 298 U. S. 415;

Leitch v. Barber, 302 U. S.

(conflict with applicable decisions of this Court).

STATEMENT.

Respondent Was Recently Before This Court on the Same Question.

Respondent was recently before this Court in two other cases-presenting precisely parallel facts and the same legal situation as in the case at bar, to wit, the cases of:

Bassick Mfg. Co. v. Hollingshead Co., } 298 U. S. 415.
Rogers et al. v. Alemite Corporation, }

The Alemite Corporation (formerly known as the Bassick Mfg. Co.) was and is a wholly-owned subsidiary and predecessor in business of the respondent Stewart-Warner Corporation. Formerly the Stewart-Warner Corporation conducted the lubricating-equipment branch of its business and held its many similar patents in the name of its said subsidiary, but more recently in its own name.

LUBRICATING EQUIPMENT

Grease-cups—Pumps—Couplers.

Petitioner and respondent are both engaged* in the sale of lubricating equipment for the lubrication of bearings of automobiles and other machinery comprising three separate and distinct classes or kinds of equipment or devices, to wit:

- a) **Grease-cups.** These are generally permanently attached to the bearings of machine to be lubricated (such as the automobile, industrial machinery, farming machinery, etc.) and which grease-cups

*Just as were both parties in *Rogers v. Alemite*, 298 U. S. 415.

Equipment Involved

are sometimes referred to as "fittings" or "nipples" (and also called by many other names both in the Butler patent in suit as well as in the prior art patents). This fluid-receiving member is variously called by many names, but when it is used to receive lubricant, it is sometimes referred to as a grease-cup and sometimes as a "nipple" or "fitting" or "lubricant-receiving member" or "lubricant receptacle", etc. The Gullborg patent (adjudicated by this Court in *Rogers v. Alemite*, 298 U. S. 415) calls the same grease-cup by many different names in various parts of the specification and claims. Sometimes it is even referred to as a "coupling element".

and

- b) **Pumps** for pumping lubricant. The pumps are sometimes referred to as the "compressor" and sometimes as the "grease-gun". Pumps vary in size and construction over a wide range. Some are small hand-operated pumps and some are larger pumps operated by compressed air and some are electrically operated.

and

- c) **Couplers or nozzles** for making temporary, fluid-tight connection between the discharge hose or connection between the discharge hose or conduit of the pump on one hand and the grease-cup on the other hand.

The term "coupler" and the term "nozzle" are often used interchangeably, but are sometimes used to distinguish between two specifically different kinds of *connectors*

generally used for making a temporary fluid-tight connection between a pump and a grease-cup.

Thus the term "coupler" is sometimes used to designate the type of *connector* device which grips or hooks onto, or mechanically interlocks with, the grease-cup, as for instance

the bayonet type coupler of Gullborg patent No. 1,307,734 (R pp 534-539 and also 298 U. S. 415), and

the various multi-jawed "chuck" type couplers having radially movable locking or gripping jaws, as that of the Seng patent No. 1,322,357 (R pp 542-544), and as that of the Newton patent No. 1,118,876 (R pp 502-505), and

the various other fixed-jaw type head-engaging couplers, as for instance that of the Dupre patent No. 927,337 (R. pp. 494-499), and that of the Winkley patent No. Re 14,667 (R pp 526-532, and also adjudicated in *Lyman et al. v. Bassick*, 18 Fed 2d, 29).

The term "nozzle", on the other hand, is sometimes used to designate the kind of *connector* (for making connection between pump and grease-cup) which is held in contact with the grease-cup *only* by pushing the device manually up against the grease-cup (while in use) and which type of *connector* is sometimes referred to as a "push-contact" nozzle;—as for instance that of the Zerk patent No. 1,475,980 (R pp 546-555, and also adjudicated in *Larkin v. Bassick*, 19 Fed 2d 944, and shown at 19 Fed 2d 946, and also adjudicated in *Hollingshead v. Bassick*, 73 Fed 2d 543).

The use of the terms "coupler" and "nozzle" has not been uniform. Indeed, petitioner sold both the "gripping" type *connector*, as well as the "push-contact" type

connector and has designated both (in its catalogues) as a "nozzle".

Thus, petitioner's "Model ND5" nozzle (which constituted the only defendant's accused device charged under the Butler patent when this suit was originally filed, as shown by bill of particulars on Record page 11) is a multi-jawed "chuck" type coupler for gripping a grease-cup and is similar to the Jiffy coupler which the Court of Appeals for the Eighth Circuit held did **not** infringe the Butler patent (81 Fed 2d 786). This petitioner's multi-jawed "chuck" type coupler catalogued by it as its "Model ND5 Nozzle" is shown in the second picture on Record page 411, and is also shown (in two forms differing in detail) in Figures 1 and 5 of the Barks patent No. 1,966,278 (R pp 578-582).

Petitioner also sells a "push-contact" type nozzle for making connection with the same grease-cups. This device is catalogued as its *KLEENSEAL* "nozzle" and is shown schematically at the top of Record page 397 and is further described on Record page 401 in connection with petitioner's grease-guns and is further illustrated in the uppermost picture on Record page 411 and is further shown on Record pages 413 and 415 and is further illustrated in colored pictures on Record page 427, and is the subject of Barks patent No. 2,010,174 shown on Record pages 584-7.

Thus, both petitioner as well as respondent sell each of the aforesaid **three** separate and distinct classes of equipment or devices, namely, (a) grease-cups, (b) pumps, and (c) couplers or nozzles;—for conjoint use with each other.

a) Petitioner's grease-cups are known in the trade as the Lincoln *KLEENSEAL* "fittings" (R p 397);

b) Petitioner's pumps are referred to in the trade as the Lincoln *KLEENSEAL* "grease-guns" (R p 401);

- c) Petitioner's coupler devices were at first known as the *LUBRIGUN* "nozzles" and later as the *KLEENSEAL* "nozzles" (R pp 411, 415, 427)
- a) Respondent's grease-cups are known in the trade as the Alemite *HYDRAULIC* "fittings";
- b) Respondent's pumps are referred to in the trade as the Alemite *HYDRAULIC* "grease-guns" or "compressors";
- c) Respondent's couplers are known in the trade as the Alemite *HYDRAULIC* couplers.

THE CHARGE OF INFRINGEMENT.

This suit was originally based on petitioner's coupler device alone, and not upon petitioner's now-accused grease-cup.

The original bill of complaint in the present suit charged infringement **only** of Butler claim 1 and **not** of the Butler claim 2 now in suit, and did **not** charge infringement against **any** grease-cup, but, as in the Jiffy suit (81 Fed 2, 786), charged infringement solely against a coupler device.*

After the decision of the trial court in the Jiffy case, respondent added Butler claim 2 to the case at bar, and also added petitioner's grease-cup to the case at bar, by an amended bill of particulars (R p 14).

After the decision of the Circuit Court of Appeals for the Eighth Circuit (81 Fed 2d 786) in the same Jiffy case, respondent **withdrew** from the issues at bar Butler claim 1† and also **withdrew** the petitioner's originally-accused coupler.

*See original bill of complaint on R p 2 and original bill of particulars on R p 11.

†At the opening of the trial at bar, R. pp. 33-35.

Charge of Infringement

In this suit, respondent is **not** charging any infringement against **any** of petitioner's equipment (grease-cups, pumps and couplers) when petitioner's devices are used together or with each other.

In the case at bar, defendant-petitioner is **NOT** charged with making or selling **ANY** couplers.

The sole charge of infringement in the case at bar is that petitioner has sold headed grease-cups or so-called lubricant-receiving "fittings" or "nipples" *for use with*

a coupler manufactured and sold by respondent allegedly under its Butler patent in suit

and an admittedly old pump also manufactured and sold by respondent (also allegedly under its Butler patent in suit).

The grease-cup, part of the Butler claim-language, to wit, the part: "a headed nipple for receiving lubricant", does **not** distinguish defendant's accused headed grease-cup or so-called "fitting" or "nipple" from the prior-art headed grease-cups.² The charge of infringement levelled at petitioner's old headed grease-cup is that of "*contributory*" infringement, and is based solely upon the *use* of petitioner's old headed grease-cup *with* respondent's assertedly Butler-improved coupler and *with* respondent's old pump.

Thus, the **sole** charge of infringement finally relied upon by respondent in the case at bar is that the sale of petitioner's **old** grease-cup *for use with* respondent's cou-

² As for instance, from the headed grease-cup of the Seng patent No. 1,322,357 (R pp 542-4) or of the Dupre patent No. 927,337 (R pp 494-9), or of the Winkley patent No. 14,667 (R pp 526-532).

plers assertedly made by respondent under its Butler patent in suit, constituted "*contributory*" infringement of the Butler patent.

DIMENSIONS—INTERCHANGEABILITY.

The Arguments Which Respondent Successfully Advanced Below Are the Same As It Unsuccessfully Advanced to This Court in Its Earlier Rogers v. Alemite Case.

In the case at bar, respondent has stressed the suggestion that petitioner's herein-accused grease-cups are specially intended by petitioner for use with respondent's allegedly Butler-improved couplers.

In the case of Rogers vs Alemite, this Court accepted respondent's identical suggestion made in that case; and nevertheless decided against respondent, on the assumption that petitioner's grease-cups in that case were intended for use with respondent's Gullborg-improved couplers.

Petitioner's (as well as respondent's) three different classes of equipment or devices (grease-cups, pumps and couplers) are each separate and independent articles or devices of general application or interchangeable use.

Because of similar dimensioning of the grease-cups of the respective parties and similar dimensioning of the couplers or nozzles of the respective parties, the petitioner's grease-guns and nozzles can be applied to and used with respondent's grease-cups for dispensing grease into said grease-cups, and, vice versa, respondent's pumps and couplers can be applied to and used with petitioner's grease-cups for dispensing grease into said grease-cups.

This precise situation was present in Rogers v. Alemite, 298 U. S. 415, where (as here) both petitioner and respondent made all three classes of equipment, to wit, grease-

cups, pumps and couplers;—with the grease-cups and couplers similarly dimensioned so that there was complete interchangeability. In Gullborg's claims 1 to 10 (involved in *Rogers v. Alemite*), as here, the invention was in the internal construction or mechanism of a coupler, and the charge of contributory infringement was levelled at the otherwise old defendant's grease-cup because it was interchangeable by virtue of similar dimensions.

The Butler patent specifies no dimensions, for obviously there could have been no invention in dimensions. The patent is, indeed, entirely silent on any question of dimensions. Insofar as any dimensions or proportions may be taken from the drawings of the Butler patent in suit, by measuring or proportioning the figures of the drawings, **neither** the dimensions nor the proportions of the grease-cups of either of the parties in the case at bar, **nor** the dimensions or proportions of the couplers or connecting nozzles of either of the parties are those of the Butler patent.

In other words, the scaling of the Butler patent drawings, in an effort to produce apparatus which follows the proportioning or dimensions shown in the Butler drawings, would produce apparatus which would not fit or would not be interchangeable with any apparatus (grease-cup, pump, or coupler) of either party at bar.

Thus, dimensions are no part of the Butler patent, and insofar as dimensions can be found in the Butler drawings, they are not the dimensions of the equipment of either party.

Moreover, the matter of dimensions is **not** material, as shown by respondent's previous unsuccessful attempt to present the **same** matter before this Court, in the *Rogers*

v. Alemite suit (298 U. S. 415), wherein respondent said to this Court:

“What the defendant-petitioners did was to make a fitting and to make a compressor which, if used together could be asserted **not*** to embody all of the details of any one claim of the Gullborg patent.

“All of the parts were, however, given precisely such **form, size and dimensions** that they could be perfectly **interchanged** with and substituted for the corresponding parts of the Gullborg system as manufactured and sold by the Alemite Corporation. If it had been the real purpose and intention of Rogers and Dusenberry to have their fittings used only in combination with their compressors, they could easily have made their coupler and fitting parts a sixty-fourth of an inch larger in diameter or smaller in diameter. They could easily have made the distance from the pin to the head a sixteenth of an inch longer or a sixteenth of an inch shorter. Any of these or like departures from the exact dimensions of the Alemite equipment would have **prevented interchangeability and conjoint use**. In this event, however, the owner of an Alemite compressor could not ‘increase his repertory’ by purchasing Rogers and Dusenberry fittings. He could not have lubricated his Alemite-equipped bearings by purchasing a Rogers and Dusenberry compressor.

“What Rogers and Dusenberry wanted was the opportunity to sell their fitting parts and their compressor parts for use in combination with the other parts which were sold by the Alemite Corporation. Consequently the Rogers and Dusenberry parts were given precisely such **dimensions** as would insure the requisite **interchangeability**.

.

*In quotations throughout this brief, emphasis is ours unless otherwise noted.

"The District Court decided that Rogers and Dusenberry had made all of their parts of such **form and dimensions** that they could be combined with the other parts of the combination as sold by the Alemite Corporation, and that they had been manufactured and sold with the expectation and intention that the purchasers would so combine them. (R p 127.)"

(Quoted from pages 6 and 7 of respondent's Brief in Rogers v. Alemite, No. 31, Oct. Term, 1935.)

This Court recognized respondent's above-quoted statement in Rogers v. Alemite, by saying:

"The petitioners did sell pin fittings (grease-cups) of the type with which a grease gun (having the improved coupler) of the description of Gullborg's could be used" (298 U. S. 423). (Parenthetical portions ours.)

This Court decided against respondent in the Rogers v. Alemite case, notwithstanding its acceptance of the facts so suggested by respondent.

THE BUTLER PATENT IN SUIT AND THE PRIOR ART.

The Butler patent in suit is based upon an *asserted* improvement of the internal construction or mechanism of hose couplers of the generically old multi-jawed "chuck" type.

While also showing a grease-dispensing pump and a grease-cup *with which* Butler's assertedly improved multi-jawed "chuck" type coupler *may be used*, the Butler patent, on its face, claims no novelty either in pumps or in grease-cups.

The pump shown in the Butler patent is nothing more than the pump of respondent's earlier and much-litigated¹ Gullborg patent (R pp 534-9) and is included in the Butler claim in suit merely by the broad and all-inclusive words "a lubricant-compressor";—a term which does **not** distinguish Butler's pump from **any** other pump of the prior art,² but instead comprehends both the forms of pumps of the prior-art of record, as well as the vast array of **all** other pumps (of varied and complex construction) devised and used before Butler and as well as since Butler.

The grease-cup shown in the Butler patent is nothing more than the headed grease-cup of the earlier Seng patent No. 1,322,357 (R pp 542-4),³ or the headed grease-cup of respondent's earlier Winkley patent No. Re 14,667 (R pp 526-532),⁴ or the headed grease-cup of the still earlier Dupre patent No. 927,337 (R pp 494-9)⁵, or the headed fluid-receiving fitting or so-called nipple of any of the other prior art patents shown on the Chart facing page 16.

The Court of Appeals for the Seventh Circuit in the case at bar clearly pointed out, in its opinion, that the **headed grease-cup** or so-called headed "nipple" shown in the Butler patent and included in the Butler claim in the all-inclusive words "headed nipple for receiving lubricant"

¹ Adjudicated by this Court in *Rogers v. Alemite* (298 U. S. 415) after respondent's sixteen-year campaign of unfounded and unwarranted patent litigation.

² Because the pump shown in the Butler patent is **not** distinguishable from the pumps of the Gullborg patent (R pp 534-9), or the Seng patent (R pp 542-4), or the Winkley patent (R pp 526-532).

³ Referred to by Seng as the "ball lubricator".

⁴ Referred to in Winkley's claims as the "headed oil receptacle" or the "lubricant receptacle".

⁵ Referred to by Dupre as the "lubricant-receiving member".

was **old and unpatentable**—the Circuit Court of Appeals saying (at 91 Fed 2d, 763; R p 673):—

"In the instant case, it is conceded that the **headed nipple was not patented**. More, it is **not patentable**. It will be assumed that **it was old**."

The broad and all-inclusive words "a headed nipple for receiving lubricant" (by which the old headed grease-cup is included in the Butler claim in suit) do **not** distinguish from **any** of the headed grease-cups or headed "nipples" of the prior-art, but instead, comprehend all the various forms of headed "nipples" shown before Butler (and also the various forms of headed "nipples" since Butler).

Thus, while Butler intended his allegedly improved coupler for *use* in coupling a grease-pump to a grease-cup, Butler clearly did **not** invent **any** pump improvement, **nor** did Butler invent **any** grease-cup improvement. Likewise, Butler was **not** the first to use a head-engaging, multi-jawed "chuck" type coupler for connecting a grease pump to a grease-cup. This was fully disclosed in the earlier Seng patent No. 1,322,357 (R pp 542-4), and grease-pumps had also been connected to grease-cups by many other conventional types of couplers, as in the Gullborg patent No. 1,307,734 (R pp 534-9), and as in the prior-art even antedating said Gullborg patent, as found by this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and as in the Winkley patent (R pp 526-532).

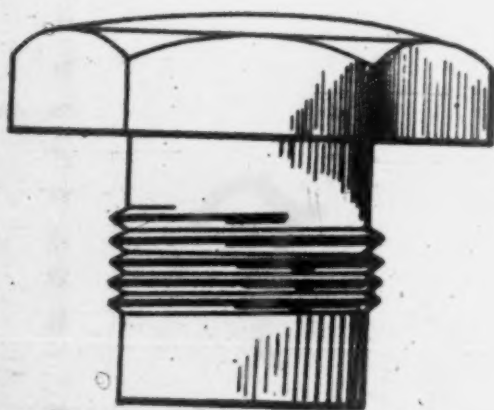
THE SO-CALLED "COMBINATION" **Of Grease-cup, Pump and Coupler.**

Not only was the "combination" of grease-cup, pump and coupler old, but it was also old long prior to the Butler patent in suit to provide:—

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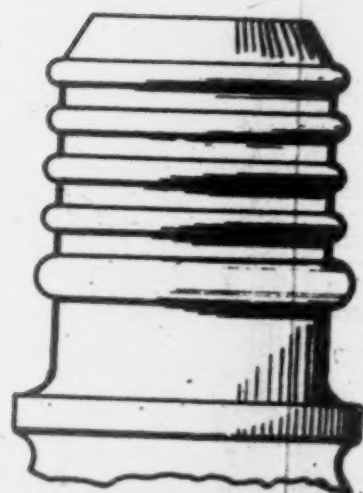
PAGE

Winkley's HEADED
lubricant-receiving
nipple of 1916
(R.p.528). Used by
Winkley in "combin-
ation" with a com-
pressor and coupler



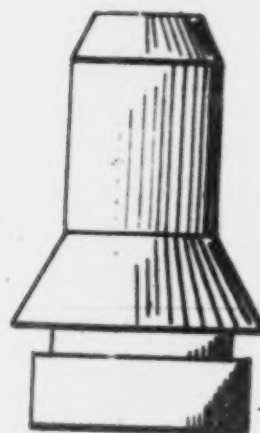
Adapted to have any
"head-engaging" hose
coupler attached to
it.

Newton's HEADED
fluid-receiving
fitting of 1914
(R.p.502)
Used by Newton
in "combination"
with a multi-jawed
fluid-actuated
"chuck"-type conduit
coupler.



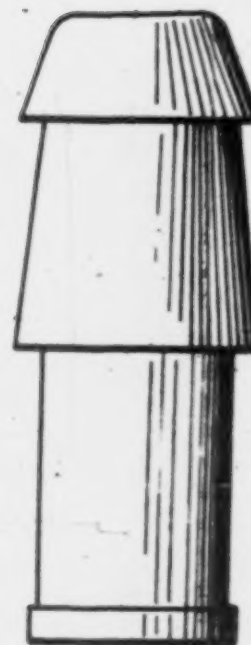
Adapted to have any
"head-engaging" hose
coupler attached to
it.

Ulleland's HEADED
fluid-receiving
fitting of 1917.
(R. p. 516)
Used by Ulleland in
"combination" with
a multi-jawed con-
duit coupler inter-
lockingly engaging
beneath the shoulder
of the head or flange
of the fitting.



Adapted to have any
"head-engaging" hose
coupler attached to
it

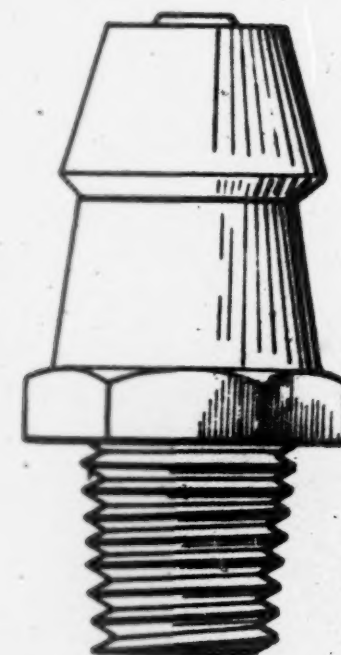
Paul's HEADED
fluid-receiving
fitting of 1897.
(R. p. 480)
Used by Paul in
"combination"
with a multi-
jawed "chuck"-
type conduit
coupler.



Adapted to have any
"head-engaging" hose
coupler attached to
it.

Butler's HEADED lubricant-
receiving fitting or nipple
(R. p. 464)

Used by Butler not only in so-
called "combination" with the
multi-jawed "chuck"-type
coupler of Butler Figure 2
and defined in the coupler
language in the Butler claims,
but also in "combination" with
the three specifically dif-
ferent and unclaimed multi-
jawed "chuck"-type hose
couplers shown in Butler
Figures 3, 4 and 9.



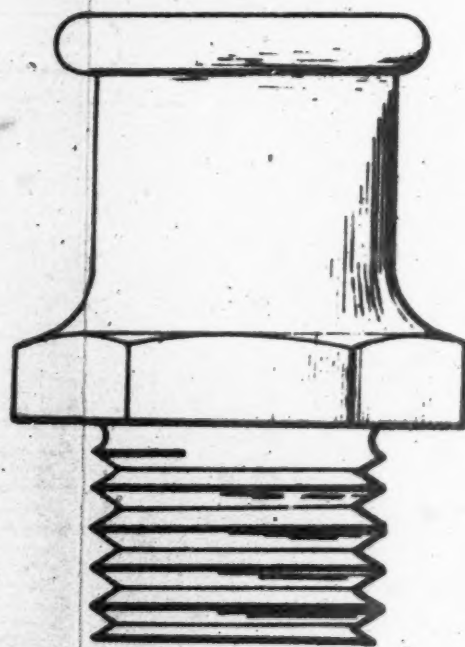
Adapted to have any
"head-engaging" hose
coupler attached to
it.

HEADED "NIPPLES" (Butler's, Petitioner's and Prior-art.)

Seng's HEADED
lubricant-receiving
fitting or nipple
of 1915

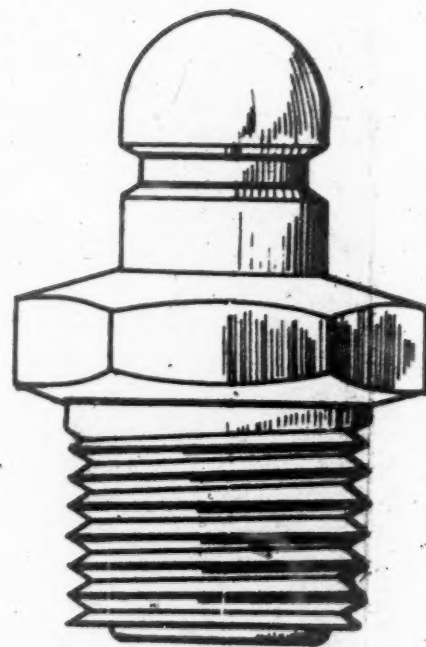
(R. p. 542)

Used by Seng in
"combination" with a
lubricant-dispensing
compressor and a
multi-jawed "chuck"-
type hose coupler
interlockingly engag-
ing beneath the head
of the "nipple" and
having a fluid ac-
tuated seal therein
for sealing against
the end of Seng's
nipple.



Adapted to have any
"head-engaging" hose
coupler attached
to it

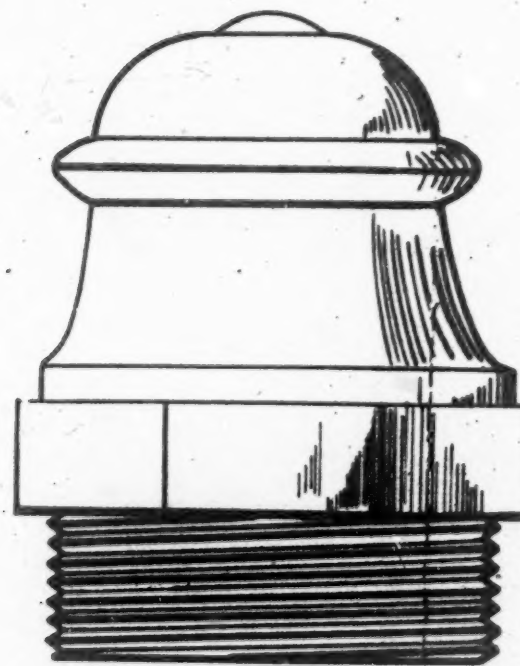
Defendant's accused
grease-cup or
lubricant-receiving
"fitting" or "nipple"



Richardson's
lubricant-receiving
fitting or nipple
of 1851

(R. p. 472)

Intended by Richard-
son to have lubricant
put into it from the
spout of an oil can.

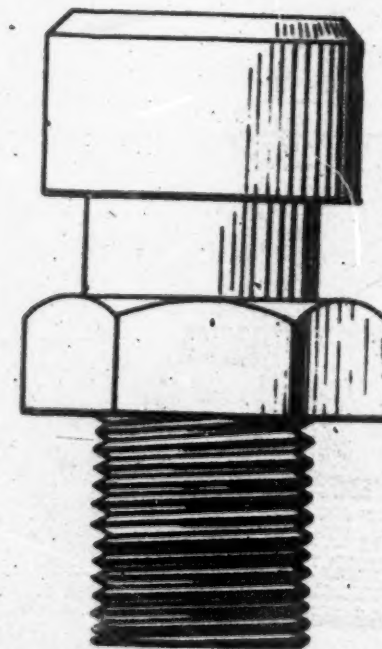


Also capable of
having any "head-
engaging" hose
coupler attached
to it

Dupre's HEADED
lubricant-receiving
fitting or nipple
of 1908

(R. p. 496)

Used by Dupre in
"combination" with
a claw-type "head-
engaging" conduit
coupler and a
lubricant compressor

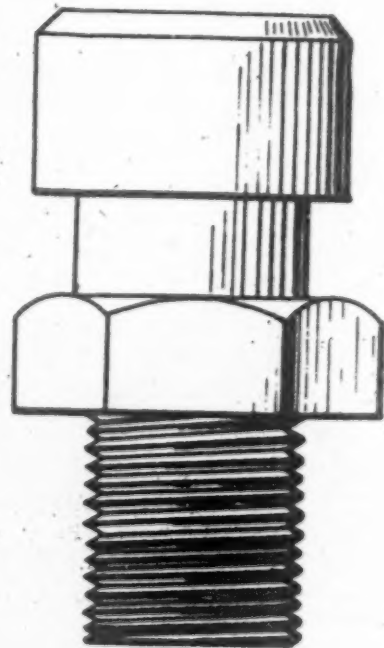


Adapted to have any
"head-engaging" hose
coupler attached
to it

Dupre's HEADED
lubricant-receiving
fitting or nipple
of 1908

(R. p. 496)

Used by Dupre in
"combination" with
a claw-type "head-
engaging" conduit
coupler and a
lubricant compressor

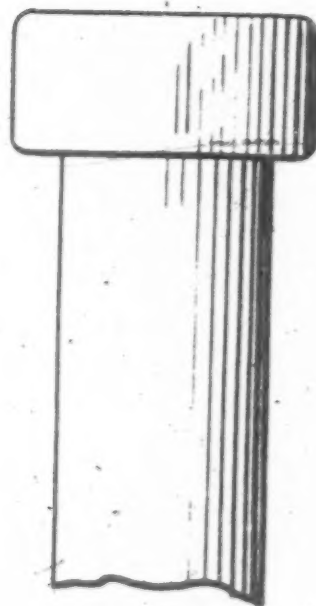


Adapted to have any
"head-engaging" hose
coupler attached
to it

Griffin's HEADED
fluid-receiving
"fitting" "E" of
Figure 5, of 1904

(R. p. 591)

Used by Griffin
with a "head-
engaging" claw-
type conduit
coupler.

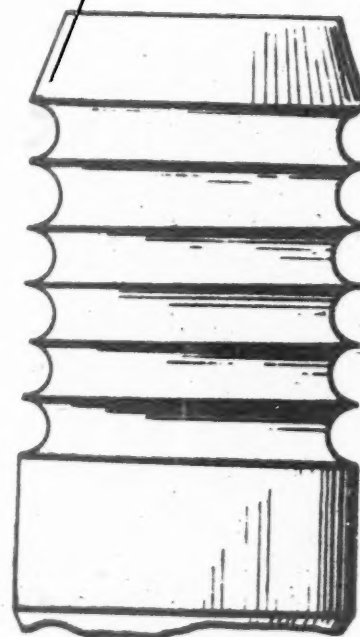


Adapted to have any
"head-engaging"
hose coupler
attached to it.

Pinel's HEADED fluid-
receiving fitting of
1902

(R. p. 597)

Used by Pinel in "com-
bination" with a multi-
jawed chuck-type hose
coupler



Adapted to have any
"head-engaging"
hose coupler
attached to it

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PAGE

- 1) "headed" type grease-cups or so-called lubricant-receiving "fittings" or "nipples" affixed to the bearings of an automobile or other machinery,
and
- 2) a perambulatory lubricant-dispensing pump,
and
- 3) a multi-jawed "chuck" type coupler on the discharge end of the pump hose for making temporary and quick-attachable and quick-detachable connection between
 - a) the pump-hose or pump-conduit, on one hand,
and
 - b) the grease-cup or so-called "nipple", on the other hand.

The antiquity of this so-called "*combination*" of (1) headed grease-cup, (2) pump and (3) "chuck" type coupler, is shown by Seng patent 1,322,357 (R. pp. 542 to 544) which discloses precisely this "*combination*" of grease-cup, pump and coupler. (See also Chart facing page 26.)

Thus, Butler (like Gullborg*) allegedly invented an improved coupler. The alleged improvement was in the internal construction or mechanism of the coupler. However, instead of just claiming his coupler, Butler claimed his coupler (with its assertedly improved features specifically defined) in so-called "*combination*" with the old-style pump and the old-style grease-up or "nipple" with which prior-art couplers had customarily been used, as shown by the following claim analysis:

*Gullborg patent 1,307,734, adjudicated by this Court in Rogers v. Alemite, 298 U. S. 415.

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Butler claim 2
analyzed:

Butler claim 2 quoted:

An old grease-cup.

"The combination with"
 "a headed nipple for receiving lubricant,
 of"

An old pump

"a lubricant compressor having"

Butler's allegedly new and improved coupler of Fig. 2 of drawings only. The Court of Appeals for the Eighth Circuit held that plaintiff-respondent's commercial "Alemite Hydraulic" coupler is not the coupler here defined, and that the coupler here defined was never produced or sold by plaintiff. (81 Fed. (2) 786.)

"a coupling member for connecting said compressor and nipple"

"comprising" (the coupler elements 1 to 5 below)

1) "a cylinder" (parts 31 & 32 in Figure 2 constituting the body or housing of the coupler).

2) "a piston (43 and 45) movable within the cylinder, and having"

3) "an aperture (48) for the discharge of lubricant thereof"

4) "an apertured sealing seat (washer 51) carried by said piston"

"for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple,"

5) "radially movable locking elements (jaws 40) carried by the cylinder coacting with the nipple and"

"actuated by said piston"

(given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).

"for compressively clutching¹ the elements upon the nipple"

"whereby the pressure of the lubricant on said piston² will move the piston² to forcibly compress¹ said means (jaws 40) while the lubricant is passing through said connecting parts."

1) By the radially compressive action of the radially resilient spring-fingers (42) carried by the piston (43 & 45).

2) The piston (43 & 45 + 42) within the coupler.

(Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

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Fundamental Question of Law in the Case at Bar.

The fundamental question of law in the case at bar (just as in the *Rogers v. Alemite* case, 298 U. S. 415), is whether one who allegedly invents an assertedly better coupler useful for connecting the old-style grease pump and the old-style grease-cup, can have a monopoly of the old-style grease-cup, by the simple expedient of including in his patent claim the old-style grease-cup, in so-called "*combination*" with his hose coupler, and then charging "*contributory*" infringement against the old grease-cups of others because usable with the patentee's assertedly improved coupler.

The confusing dual-use of the word "combination"

In its repeated attempts* to monopolize old pumps and old grease-cups through some alleged *coupler improvement*, respondent was faced with the obvious antiquity of the idea of connecting pumps to grease-cups by means of couplers. In order to overcome this obstacle, respondent resorted to the scheme of dramatizing the mere use of an allegedly improved coupler to connect the old pump with the old grease-cup, by *calling* such conjoint use (of these three separate and independent devices) a "*combination*".

In this latter sense in which the word "*combination*" is used, it merely signifies the *conjoint use* of two or more separate and distinct devices customarily used together;—as for instance, *conjoint use* of an electric lamp socket and an electric bulb, or the *conjoint use* of a fire engine and a

* Gullborg patent No. 1,307,734 (R pp 534-9) litigated in over three hundred suits and adjudicated by this Court in *Rogers v. Alemite* (298 U. S. 415).

fire hydrant and a coupler by which fire engines and fire hydrants are customarily connected, or the *conjoint use* of a screw driver and a screw, or the *conjoint use* of a door jamb, a door and a lock. All these complementary devices are "*combined*" with each other in the sense that they are *used conjointly* with each other, and indeed they must be *used with each other* in order to have utility. In that sense, there is hardly a mechanical or electrical device which is not "*combined*" with one or more other separate, distinct and independent devices in its normal and intended use. Thus, the electric iron is "*combined*" with an electric plug and an electric cord and, indeed, with a pair of electric wires and an electric generator at the power house. In the same sense, an engine of an automobile is "*combined*" with a clutch, a gear-shift, differential, wheels and a chassis. However, the use of the word "combination" in this sense should not be confused with the use of the word "combination" in the sense where it refers to the combination of the elements which compose one allegedly new and improved device. Thus, the combination of elements which compose a new lock, should not be confused with the so-called "*combination*" of improved lock with the old door and door jamb, as this latter "*combination*" spells nothing more than the *conjoint use* of the improved lock with the old door and door jamb.

The lower courts in the case at bar have been confused by this dual use of the word "combination" and have confused

the combination of coupler-composing elements, that is, the combination of elements which go to make up an allegedly improved coupler (which may be patentable), and

the so-called "*combination*" or (or conjoint use) of the assertedly improved coupler *with any old devices* with which couplers are customarily used and which are customarily coupled to each other through such couplers (as for instance with an old pump and an old grease-cup).

Obviously, in this latter sense the word "*combination*" merely signifies the *conjoint use* of two or more separate and distinct devices.

Thus, while Butler (like Gullborg in claims 1 to 10) at best only invented an improved coupler,¹ he did not stop at merely claiming his assertedly improved coupler, that is, the possibly patentable combination of elements which go to make up or compose his assertedly improved coupler, as required by Section 4888 of the Revised Statutes,² but instead (just like Gullborg), claimed his assertedly improved coupler in so-called "*combination*" with **all old pumps and all old grease-cups** with which it may be *used*;—which old pumps and old grease-cups merely constitute the old mechanical environment in which the patentee's assertedly improved coupler (just as the prior-art couplers) must necessarily be used.

The Essence of Respondent's Position.

In regard to this fundamental question of law, respondent's entire position with respect to the old grease-cup

¹ And petitioner does not admit that Butler even invented a better or different coupler or one patentable over the prior-art couplers.

² "Before any inventor or discoverer shall receive a patent for his invention or discovery, he . . . shall file . . . a written description . . . so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, the improvement or combination which he claims as his invention or discovery." (U. S. C. Title 35, Section 33).

resolves itself into the proposition that respondent should have a monopoly of the old grease-cup, because the old grease-cup never had the experience of meeting a Butler coupler until there was a Butler coupler.

This Court held (298 U. S. 415) that respondent is not entitled to such a monopoly of old grease-cups.

Butler's alleged improvement in the internal construction or mechanism of a COUPLER.

Couplers are some of the most common devices, and are used for making fluid-tight connection between the fluid-delivery conduit or any fluid-supply line or pump, and some other member to which the fluid is to be supplied.

Multi-jawed "chuck" type couplers were old prior to Butler and had been used both

for connecting a grease pump to a grease-cup, as for instance in the early Seng patent No. 1,322,357 (R pp 542-4),

as well as

for connecting other fluid pumps (such as air pumps) to other receiving members or "fittings", as for instance in the early Newton patent No. 1,118,876 (R pp 502-5).

While the Butler patent in suit discloses four specifically different couplers¹ of the multi-jawed "chuck" type, the coupler-part of the Butler claim-language is readable only upon one of the four Butler couplers disclosed, to wit, that shown in Butler Figure 2. The other three Butler

¹ Shown respectively in Figures 2, 3, 4 and 9 of the Butler drawings.

couplers (while shown and described in the patent) are not covered in any claim (presumably because they were conceded old and unpatentable multi-jawed "chuck" type couplers).

The coupler of Figure 2* of the Butler patent is merely one of a long line of multi-jawed "chuck" type couplers old in the art, as shown by the Seng patent (R pp 542-4) and the Newton patent (R pp 502-5) and the Paul patent (R pp 480-2).

The colored chart facing page 26 is divided into approximately three equal sections.

The section on the extreme left shows the Butler Figure 2 coupler and "nipple", and the Newton coupler and "nipple", and the Seng coupler and "nipple".

In the center section, we have shown the Jiffy coupler and "nipple" and respondent's own coupler and "nipple" (assertedly under the Butler patent) all of which were adjudicated (unfavorably to respondent) in *Stewart-Warner v. Jiffy* (81 Fed. 2d 786; C. C. A. 8).

In the right-hand section, we have shown the respondent's own coupler and petitioner's grease-cup or "nipple";—the *conjoint use* of which (together with an old pump) is charged to constitute the **only** infringement in the case at bar (the coupler and pump being sold by respondent and the grease-cup alone being sold by petitioner).

In this chart, we have colored the corresponding parts of the different couplers with the same colors.

The so-called "nipple"† is colored blue in each instance.

* The only one of the four couplers shown in the Butler patent upon which the coupler-part of Butler's claim-language is readable.

† which when used as a lubricant-receiving element is the "grease-cup".

The outer housing of the coupler or the coupler-body (sometimes called the "cylinder" and sometimes called the "sleeve" or the "shell") is colored green.

The plurality of circumferentially distributed and radially movable locking-jaws or gripping members are colored red.

The piston and its associated parts are colored purple in each case. In both Butler and Newton, the piston has associated with it spring fingers (marked 42 in Butler, and marked 9 in Newton) which are colored purple as a continuation of the piston. (Seng has no jaw-actuating piston, but instead has an outer jaw-actuating sleeve which has been similarly colored purple.)

It is because of the absence of these spring-fingers in both the Jiffy coupler as well as in respondent's own commercial coupler, that the Court of Appeals for the Eighth Circuit in *Stewart-Warner v. Jiffy*, supra, held that both the Jiffy coupler as well as respondent's own coupler were outside the scope of the coupler-part of the Butler claim-language.*

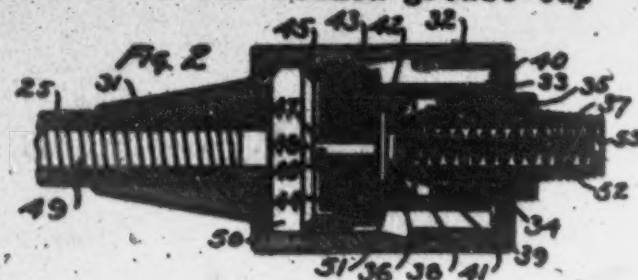
*The Butler claim-language requires means "for compressively clutching" and "to forcible compress" Butler's "radially movable locking elements" (40, red) (upon the nipple" (blue). The only such means in Butler's Figure 2 coupler are the **radially-resilient spring fingers 42**, which supply **radially resilient spring-compression** to the radial actuation of the locking elements (40, red). Butler ascribes some special advantage to such spring-compression, but neither respondent's commercial coupler nor Jiffy's coupler embody this feature. In the Jiffy case the Court of Appeals for the Eighth Circuit correctly held that both Jiffy's coupler and respondent's commercial coupler lacked Butler's spring fingers.

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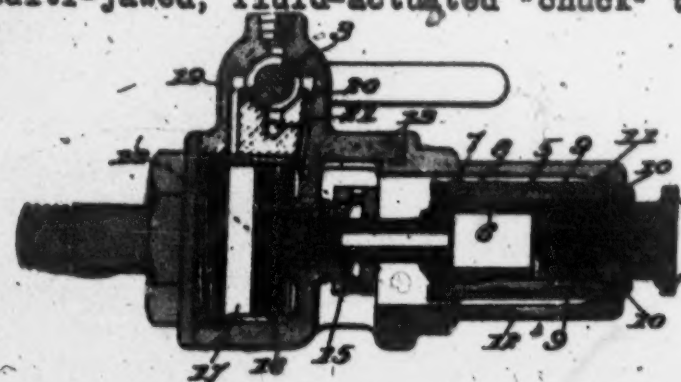
PAGE

BUTLER and the PRIOR-ART

BUTLER'S assertedly improved HOSE-COUPLER of the multi-jawed, fluid-actuated "chuck" type coupled to an OLD headed grease-cup



NEWTON'S earlier HOSE-COUPLER of 1914 of the multi-jawed, fluid-actuated "chuck" type



SENG'S 1915 HOSE-COUPLER for GREASE-GUNS and SENG'S headed GREASE-CUP or "nipple" of 1915

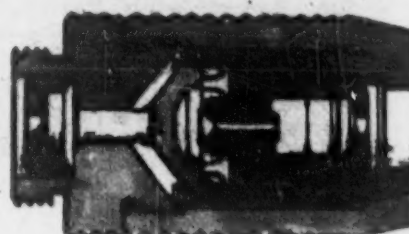


SENG'S locking jaws (red) are manually actuated as distinguished from the "fluid-actuation" of the locking jaws in Newton and Butler although Seng's sealing member (orange) is "fluid-actuated" precisely as in Butler.

The DEVICES before the

Circuit Court of Appeals for the Eighth Circuit in Respondent's suit against Jiffy Lubricator Co. 81 Fed 2d 786 (certiorari denied 299 U.S. 554)

JIFFY'S Coupler held OUTSIDE the scope of Coupler Part of BUTLER claim-language

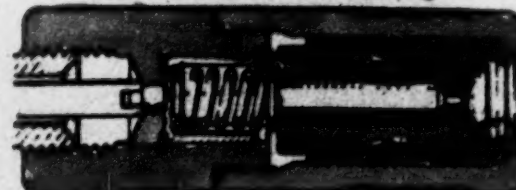


Respondent's own "pin-fitting" type grease-cup asserted (in the Jiffy suit) to be the "nipple" of BUTLER claim 1



This is grease-cup of Respondent's now-expired Gullborg pat. 1,307,734 which the Court at 298 U.S. 415 held could NOT be broadly re-monopolized under said earlier Gullborg patent

Respondent's OWN COUPLER ("Alemite Hydraulic") held OUTSIDE the scope of coupler part of BUTLER claim-language.

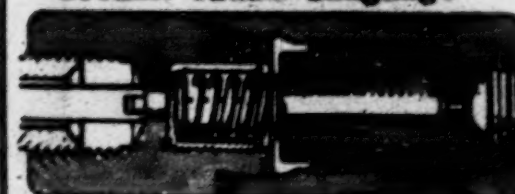


Respondent's OLD and unpatentable headed grease-cup



The DEVICES before the Circuit Court of Appeals for the Seventh Circuit IN THE CASE AT BAR: 91 Fed 2d 757

Respondent's OWN COUPLER ("Alemite Hydraulic") held WITHIN the scope of coupler part of BUTLER claim-language



Petitioner's OLD and unpatentable headed grease-cup



The ONLY accused device in THE CASE AT BAR

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The sealing means is colored orange in each case. The sealing means in both Butler, as well as Newton, as well as Seng, as well as in the Jiffy coupler, are all of soft resilient material such as leather or rubber or the like. Indeed the Butler coupler uses the old-fashioned cup-shaped leather gasket of the Seng patent and of the Gullborg patent. Respondent's own coupler does not use a soft packing or sealing member but instead uses a hard steel plunger which, however, has been similarly colored orange.

With the interpretation of the coupler-parts of the Butler claim-language necessary to respondent's charge of infringement,** the coupler-part of the Butler claim-language is fully readable upon the coupler of the Newton patent (R pp 502-5).

In the following two parallel columns, we have quoted the corresponding coupler-parts of the claim-language of both Butler claims (1 and 2), and after the successive paralleled portions of the coupler-parts of Butler claims 1 and 2, we have pointed out the corresponding parts in the coupler of the Newton patent (R pp 502-5):

** Respondent's charge of "contributory" infringement levelled at petitioner's old grease-cup is dependent, inter alia, upon giving the coupler-parts of the claim-language an interpretation readable on respondent's own commercial coupler.

**The COUPLER-PARTS of the Butler Claims.
Compared and Applied to Newton's COUPLER.**

Butler Claim 1.

Butler Claim 2 in Suit.

Scope adjudicated by C C A Claim held invalid at 15 F.
8 (81 Fed 2d 786). Supp. 410,
(Certiorari denied 299 U. S. on authority of 298 U. S. 415.
554.)

"a coupling for connect-... "a coupling member for connect-
ing said compressor and ing said compressor
nipple," and nipple"

Newton's device is a coupling.

"the coupling compris-.... "comprising" (*coupler ele-*
ing" (*coupler elements ments 1 to 5 below*)
1 to 5 below)

1) "a cylinder" (*parts 31 & 32 in Fig. 2 constituting the body or housing of the coupler*). 1) "a cylinder" (*parts 31 & 32 in Fig. 2 constituting the body or housing of the coupler*.)

This is Newton's cylinder or sleeve 12.

2) "a piston (43 & 45)... 2) "a piston (43 and 45
movable within the cyl- movable within the cyl-
inder, and having" inder, and having"

This is Newton's piston 16 to which is fastened
the tubular piston rod or stem 15 and the
carrying plate 8

3) "an aperture (48) for.. 3) "an aperture (48) for
the discharge of lubri- the discharge of lubri-
cant therethrough, and" cant thereof"

This is the hole or small passage 18 through
Newton's piston

4) "an apertured seat"... 4) "an apertured sealing
(*washer 51*) seat (*washer 51*) carried
by said piston"

"for engagement with.. "for engagement with
the end of the nipple," the end of the nipple,
connecting the piston ap-
erture with a passage
through the nipple,"

This is Newton's "packing tube 5" or sealing
member

COUPLER PARTS of Butler Claims (continued).

Claim 1

- 5) "means (*jaws 40*) carried by the cylinder"

Claim 2

- 5) "radially movable locking elements (*jaws 40*) carried by the cylinder coacting with the nipple and

These are the outermost ends 10 of Newton's spring fingers 9, which outermost ends serve as locking elements for engaging the head or bead of Newton's nipple 4

Newton's locking elements 10 are carried by his cylinder 12 in the same sense as they appear in respondent's commercial coupler.

"for compressively engaging about the nipple"

"for locking said parts together against longitudinal displacement and"

"actuated by said piston".

(43 & 45 + 24)

(given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).

"actuated by said piston" (given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).

"for compressively clutching the elements upon the nipple"

Newton's locking elements 10 are "actuated by said piston for compressively clutching the (locking) elements upon the nipple".

*By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45.

COUPLER PARTS of Butler Claims (continued).**Claim 1**

"whereby the pressure.. of the lubricant on said piston ¹ will move the piston ¹ to forcibly compress ² said means (jaws 40) while the lubricant is passing through said connecting parts."

In Newton's coupler, too, the pressure of the fluid in the coupler moves the piston, forcibly to compress the locking jaws 10, through the radially compressive action of Newton's spring-fingers 9.

Claim 2

"whereby the pressure of the lubricant on said piston ¹ will move the piston ¹ to forcibly compress ² said means (jaws 40) while the lubricant is passing through said connecting parts."

1) *The piston (43 & 45 + 42) within the coupler.*

2) *By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).*

(Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

Thus, insofar as the coupler-part of Butler's claim-language may be given such interpretation as to be readable upon respondent's own commercial coupler, it is also readable upon the Newton coupler.

Or stating it otherwise, if the coupler-part of Butler's claim-language is given any interpretation which might distinguish the Butler coupler from the Newton coupler, then the same interpretation of Butler's claim-language will also distinguish respondent's own commercial coupler from Butler's coupler.

The Court of Appeals for the Eighth Circuit in the case of *Stewart-Warner Corporation v. Jiffy* (81 Fed 2d, 786) tried to save the Butler patent from invalidity over the New-

ton patent (and other patents) and so held that respondent's own commercial coupler, as well as the Jiffy coupler, were **not** in accordance with the *only* Butler coupler upon which the Butler claim was readable (Butler Figure 2 coupler), and held that there was no infringement. Finding no infringement, the Court could (and did) treat the question of the validity of the Butler patent more leniently—in line with the practice of some courts to hold a patent not infringed, if possible on a narrow interpretation, rather than to hold the patent invalid, notwithstanding that the broader interpretation of the claim urged by plaintiff makes it clearly readable on the prior-art.

Thus, if a narrow construction of the claim-language results in non-infringement, there is generally no need for holding the patent invalid, even though the distinctions between the prior-art and the narrowest construction of the claim-language are still very doubtful.

The only faint distinction which respondent has so far been able to advance between the coupler-part of the Butler claim language and Newton's multi-jawed and fluid-actuated "chuck" coupler, is based upon a super-added limitation of the word "end", which word at best is merely a part of a functional statement about Butler's "apertured sealing seat" in the claim. Respondent has contended that the word "end" in the Butler claim should be given a limited meaning to differentiate from Newton's tubular (apertured) sealing gasket.

Thus, while Newton's tubular (apertured) sealing gasket 5 (orange colored in Chart facing page 26) is clearly "for engagement with the *end*" of Newton's fluid-receiving "fitting" or "nipple" 4 (blue in Chart facing page 26), respondent has urged that the word "end" should be limited to an **axially** directed engagement with the end of the

"nipple" as distinguished from the engagement of the same end of the "nipple" in a radial direction as in Newton.

In Newton's coupler, just as in Butler's coupler, the locking-jaws (colored red), as well as the sealing gasket (colored orange), are fluid-actuated;—that is, the greater the pressure of the fluid in the coupler, the harder will the locking-jaws (red) and the sealing-gasket (orange) be pressed into "engagement with the end of the nipple" as stated by Butler's claim-language. The only difference is that Newton's sealing gasket (orange) is pressed into "engagement with the end of the nipple" in a radial direction, while Butler's sealing gasket (red) is pressed into "engagement with the end of the nipple" in an axial direction (with reference to the longitudinal axis of the generally tubular "nipple" and coupler).

This difference is not expressed or implied in Butler's claim-language.

Moreover, if this limitation is read into the coupler-part of Butler's claim-language in an effort to develop some real or imaginary distinction between Newton's coupler and the coupler-part of Butler's claim-language, such distinction is without patentable significance because it, at best, merely spells the substitution of Gullborg's (R pp 534-9) or Seng's (R pp 542-4) conventional axially-sealing "cup-washer" (colored orange in Chart facing page 26) in place of Newton's radially-sealing tubular washer.

Thus, the very thing (the axially-sealing washer) which was the basis of respondent's claim of invention for Gullborg's coupler (298 U. S. 415), is now attempted to be read into the coupler-part of Butler's claim-language as the sole distinction between the coupler-part of Butler's claim-language and Newton's old multi-jawed fluid-actuated "chuck" coupler.

Thus, at best, it is merely upon the substitution of Gullborg's or Seng's axially-sealing cup-washer, in place of Newton's radially-sealing tubular gasket, **within the mechanism of the old multi-jawed "chuck" type couplers**, that respondent bases its claim of monopoly on **all headed grease-cups and all pumps** which may be *usable* with the assertedly improved coupler.

This Court in *Rogers v. Alemite*, *supra*, held that respondent could not have a monopoly of all pumps and grease-cups usable with Gullborg's assertedly improved coupler, where that coupler was likewise claimed to be distinguished from the prior-art "bayonet" type couplers by the **same axially-sealing washer**.

The factual situation is exactly parallel and the legal situation is precisely the same in the case at bar as in the recent case of *Rogers v. Alemite* (298 U. S. 415) involving respondent's earlier Gullborg patent.

The Butler patent in suit (just like respondent's earlier Gullborg patent No. 1,307,734 which was adjudicated by this Court at 298 U. S. 415), discloses several separate and distinct mechanical devices, each complete in itself and each having a separate and independent status in the art of lubrication* and constituting separate articles of commerce and manufacture;—said several separate and distinct devices having been customarily used in conjunction with each other.*

The only relationship existing between said several separate and distinct devices is that each device constitutes

*Long prior to Butler's application for the patent in suit.

the generically old environment in which the other devices are customarily used.

(It is much the same as an incandescent electric bulb or lamp is customarily used with an electric socket or vice versa; or much the same as a screw is customarily used with a screw driver, or vice versa; or much the same as a bottle-cap opener is customarily used with a bottle-cap and bottle or vice versa; or much the same as a fire engine is customarily used with a fire hydrant in the street and a hose-coupler in connection therewith; and so on ad infinitum).

The subject-matter of the Butler patent in suit is generally the same as the subject matter of respondent's earlier and much litigated Gullborg patent No. 1,307,734, to wit:

- (A) A grease-cup or so-called "fitting" or "nipple" adapted to be secured to the various bearings of an automobile or other machinery;
- (B) A separate and generally portable grease pump, compressor or so-called "grease-gun" for pumping grease under suitable pressure, and
- (C) A hose-coupler on the end of the discharge hose of the grease pump or compressor or "grease gun", for temporarily making a fluid-conducting connection between the discharge hose of the pump or compressor, on one hand, and the grease cup, fitting or nipple, on the other hand.

This was recognized by the Seventh Circuit Court when it said:

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the

patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler. (91 Fed 2d 761; R. p. 633.)

Indeed, right up to the time respondent suffered the adverse decision of this Court on its earlier Gullborg patent (298 U. S. 415)

respondent had firmly relied* upon the many decisions† of the Courts on its earlier Gullborg patent which this Court thereafter reversed (either directly or in effect) in the cases of Bassick v. Hollingshead and Rogers v. Alemite (298 U. S. 415); respondent having contended* that its earlier Gullborg patent No. 1,307,734, and the many prior adjudications thereon favorable to it, presented cases "on all fours" with the situation under its more recent Butler patent here involved.

*Both in the trial court in the case at bar, as well as in the trial court in its companion suits on the same Butler patent (decision is reported at 15 Fed. Supp. (410).

†Bassick v. Auto Equipment, 13 Fed 2d 463 (CCA 7).

Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6).

Larkin v. Bassick, 19 Fed 2d 944 (CCA 7).

Bassick v. Adams, 52 Fed 2d 36 (CCA 2).

Alemite v. Rogers, 5 F. Supp. 940 (D. C.).

Rogers v. Alemite, 74 Fed 2d 1019 } Reversed at
(CCA 3). } 298 U. S. 415.

The situation in the case at bar is in fact "on all fours" with the situation before this Court on claims 1 to 6 and 8 and 10 of Gullborg patent No. 1,307,734 in *Rogers v. Alemite*, 298 U. S. 415.

This Court in said case of *Rogers v. Alemite* (298 U. S. 415) held that a patentee could **not** thus re-monopolize the old-style grease-cup or so-called "nipple" or "fitting" under the guise of a patent predicated upon a coupler improvement. Respondent's scheme and attempt to so monopolize an old style grease-cup

by including such old style grease-cup in a patent claim in so-called "combination" with the inventor's hose coupler, and

by then charging "contributory" infringement against the old style grease-cups usable with his hose coupler,

was condemned by this Court in said recent *Rogers v. Alemite* case (298 U. S. 415)

The trial court in the case at bar failed to follow this Court's decision in *Rogers v. Alemite* (298 U. S. 415)

notwithstanding respondent's own contention before that court that the prior decisions of the courts on its earlier Gullborg patent No. 1,307,734** consti-

***Bassick v. Auto Equipment*, 13 Fed 2d 463 (CCA 7).

Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6).

Larkin v. Bassick, 19 Fed 2d 944 (CCA 7).

Bassick v. Adams, 52 Fed 2d 36 (CCA 2).

Alemite v. Rogers, 5 F. Supp. 940 (D. C.).

Rogers v. Alemite, 74 Fed 2d 1019 Reversed at
(CCA 3) 298 U. S. 415.

tuted controlling authorities for respondent's position under its more recent Butler patent No. 1,593,791 here in suit

and

notwithstanding that respondent's controlling authorities were subsequently reversed by this Court in *Rogers v. Alemite* (298 U. S. 415), after respondent had so firmly relied upon such authorities in its brief to the trial court herein.

The sole distinction relied upon by the trial court between

the Butler patent in the case at bar

and

the earlier Gullborg patent in *Rogers v. Alemite* (298 U. S. 415)

was the supposedly greater "*pioneer*" character of Butler's more recent invention. The District Court said:

"The rather startling features of the Supreme Court's opinion is the announcement that the Leeds case, patent to Berliner 534,543, was a pioneer patent." (15 F. Supp. 577; R p 613.)

"The situation is not one where the language of the Supreme Court in the Gullborg case is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer." (15 F. Supp. 579; R p 616.)

The trial court in the case at bar failed to accept this Court's recent interpretation of the Leeds & Catlin case (in *Rogers v. Alemite*) and expressed its disagreement by saying that Butler was a pioneer in the same sense as this Court used the word "*pioneer*" in *Rogers v. Alemite*. In so char-

acterizing Butler, the trial court disregarded the absolute parallelism between the case at bar and the case of *Rogers v. Alemite*, a parallelism urged upon the trial court by respondent itself, just before this Court handed down its decision in *Rogers v. Alemite*.

However, the Court of Appeals in the case at bar deprived Butler of the position of a "pioneer", just as did the Court of Appeals for the Eighth Circuit in the Jiffy case.

Thus, the Court of Appeals for the Eighth Circuit in the Jiffy case said:—

"Although none of these patents actually anticipates the claim of the Butler patent covering his coupler adapted for lubricating apparatus, they preclude any conclusion that his was a pioneer patent in the art of making automatic chucks." (81 Fed. 2d 792.)

The Court of Appeals for the Seventh Circuit in the case at bar in turn said:—

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

"While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the

facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling." (91 Fed 2d 761; R. p. 633.)

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old."

(91 Fed 2d 763; R. p. 637.)

"We are not convinced that the discovery belongs to the pioneer class. It was an improvement, but not an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated."

(91 Fed 2d 765; R. p. 642.)

Thus, notwithstanding the fact that the Court of Appeals for the Seventh Circuit in the case at bar deprived the trial court's decision of its sole support with respect to the attempted distinction between the Gullborg patent in the *Rogers v. Alemite* case and the Butler patent in the case a bar;—the Court of Appeals nevertheless erroneously failed to follow the clear and unmistakable and admittedly controlling decision of this Court in the *Rogers v. Alemite* case.

Likewise, while clearly holding that Butler was not a pioneer and while even entertaining serious doubts as to there being any patentable invention in *Butler's coupler*, the Court of Appeals in the case at bar nevertheless gave the coupler-part of the Butler claim-language a broader construction than was given to it by the Court of Appeals for the Eighth Circuit, and in so doing reached a decision as to the scope of the Butler patent in conflict with that reached by the Court of Appeals for the Eighth Circuit in the *Jiffy* case.

The Decision (CCA 8) in Stewart-Warner v. Jiffy.

In the case of Stewart-Warner v. Jiffy (81 Fed 2d, 786; CCA 8) the so-called "*combination*" of claim 1 of the Butler patent (like claim 2 in form and substance) was not asserted against defendant's grease-cup for use with plaintiff's coupler and pump as was claim 2 in the case at bar, but it was asserted against defendant's coupler and pump for use with plaintiff's grease-cup of the old "bayonet" type manufactured by plaintiff under its older Gullborg patent 1,307,734 (which older Gullborg grease-cup or "fitting" was thus *made* the "nipple" of the more recent Butler patent).

Jiffy's accused coupler had dimensions to fit onto and to be usable with the old "pin-fitting" type grease-cup manufactured and sold by respondent

under respondent's earlier Gullborg patent No. 1,307,733, which claimed its particular form of grease-cup *per se*, and

under claims 14 & 15 of respondent's earlier Gullborg patent No. 1,307,734, which claimed its particular form of grease-cup device in alleged "*combination*" with the admittedly old pump, old hose and old coupler of the prior art, and

under claims 1 to 6 and 8 & 10 of the same earlier Gullborg patent No. 1,307,734, which claimed the grease-cup device *generically* (to include both old and new grease-cups) in alleged "*combination*" with an assertedly improved hose coupler and an admittedly old hose and old pump of the prior-art.

In the case at bar, the charge of *contributory* infringement is levelled at petitioner's old-style grease-cup or so-

called "fitting" or "nipple" because usable with the assertedly Butler-invented couplers *manufactured and sold by respondent*.

In the Jiffy case, the charge of *contributory* infringement was levelled at an asserted Butler-invented coupler of Jiffy's manufacture **when used with an old Gullborg "pin-fitting" type grease-cup made and sold by respondent** under its now expired Gullborg patents.

Both plaintiff-respondent's *assertedly* Butler-invented coupler, as well as Jiffy's *assertedly* Butler-invented coupler are **different** from the only coupler (of the several couplers) disclosed in the Butler specification and drawings upon which the coupler-part of the Butler claim-language is readable (the coupler of Butler Figure 2).

Respondent urged upon both Courts in the Jiffy case that the coupler part of the Butler claim-language should be given a broad interpretation on the ground that unless given such broad interpretation, the coupler part of the Butler claim-language would **not** even cover respondent's own commercial form of coupler asserted by it to have been made under the Butler patent; respondent urging upon the Courts in the Jiffy case (and both Courts finding) the substantial identity between Jiffy's accused coupler and respondent's commercial coupler known as the "Alemite Hydraulic coupler".

However, both

in order to maintain necessary concordance and harmony between the coupler part of the claim-language and the applicable parts of the specification and drawings of the Butler patent upon which the claim was readable, and so to give some meaning to the otherwise vague and indefinite claim-language

as well as

in order to save the Butler patent from invalidity in the Jiffy suit in view of very similar prior-art hose-couplers,

the trial court as well as the Court of Appeals for the Eighth Circuit (in the Jiffy case) construed the coupler part of the Butler claim-language in the light of Butler's specification and drawings,* and the narrow scope so afforded the coupler part of the claim-language not only exculpated Jiffy's accused coupler, but, in the opinion of the Court of Appeals for the Eighth Circuit, equally well and definitely excluded from the scope of the Butler patent respondent's own commercial couplers assertedly made under the Butler patent. This is the very same coupler ("Alemite-Hydraulic") in conjoint use with which your petitioner's old style grease-cup or "nipple" is here charged contributorily to infringe.

Indeed, the Court of Appeals for the Eighth Circuit found that respondent's said commercial coupler was copied by respondent from Jiffy's coupler which Jiffy had submitted to respondent prior to respondent's commercialization of this type of coupler.

The appellate decision in the Jiffy suit, if followed in the case at bar, would therefore of necessity also exculpate your petitioner's herein accused grease-cup upon a further

*That is, the only parts of the Butler specification and drawings upon which the Butler claim is readable. The Butler claim is clearly not readable upon anything but Figure 2 of the Butler drawings and the corresponding portions of the specification, to wit, the portions of the specification beginning in line 87 of page 2 of the Butler specification (R. p. 468), down to line 5 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

ground of non-infringement, because the charge of *contributory* infringement levelled at petitioner's grease-cup at bar, is predicated and is absolutely dependent upon respondent's commercial hose-couplers **being** within the scope of its Butler patent.

Because of the necessarily limited scope of the coupler part of the Butler claim-language, the defendant Jiffy did not urge the further defect in the Butler claim 1, fatal to its very validity, to wit, the unwarranted inclusion therein of the admittedly old-style grease-cup and the admittedly old-style pump.

If respondent had prevailed in the Jiffy suit, it would there have had not only a monopoly of the Jiffy coupler, but also a second 17-year monopoly of the old "Alemite pin-fitting" of its now expired and widely litigated Gullborg patents (298 U. S. 415); for if respondent had prevailed in the Jiffy case, then under respondent's theory of the case at bar, the manufacture and sale of the old "Alemite pin-fitting" would have constituted *contributory* infringement of its more recent Butler patent here in suit, because such old "Alemite pin-fitting" would be usable with a hose-coupler which would then have been held to respond to the coupler part of the language of Butler claim 1.

While the Jiffy decision was on Butler claim 1 and the decision in the case at bar on Butler claim 2, the coupler parts of the language of these two claims are indistinguishable in substance, as will readily be apparent from the two parallel columns on pages 28-30 of this brief, where the coupler parts of the language of both Butler claims 1 and 2 are set out verbatim in two parallel columns.

SPECIFICATION OF ERRORS.

The errors which petitioner urges are the following:

- 1) The Court of Appeals for the Seventh Circuit erred in holding†

that the hose coupler purported to be defined in the coupler-part of the Butler claim-language* is both patentably different from the prior-art couplers, and at the same time holding†

that such coupler-part of the Butler claim-language is broad enough to include plaintiff-respondent's commercial coupler (specifically different from that shown in Butler Figure 2), *in conjoint use with* which petitioner's old grease-cup is charged "*contributorily*" to infringe.

- 2) The Court of Appeals for the Seventh Circuit erred in holding† Butler claim 2 both valid and at the same time infringed by the *conjoint use* of an old pump and a so-called "Alemite-Hydraulic" coupler sold by respondent, with an old grease-cup sold by petitioner.†

- 3) The Court of Appeals for the Seventh Circuit erred in holding,† in effect, that the inventor of a presumably improved and patentable coupler can validly claim his specific coupler *in combination with* an old grease-cup (or so-called lubricant-receiving "nipple") and an old pump or compres-

† in direct conflict with *Stewart-Warner Corp. v. Jiffy Lubricator Co.* (81 Fed. 2d 786; C. C. A. 8) as to the scope of the coupler-part of the Butler claim-language.

* Different claims of the Butler patent were involved, but the coupler-parts of the claim-language are substantially the same in both instances (see pages 28-30 herein).

‡ in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of *Rogers v. Alemite* (298 U. S. 415).

sor; with which two **old** devices, couplers of the prior-art had theretofore been used, and without which two **old** devices the inventor's improved coupler has no utility.

4) The Court of Appeals for the Seventh Circuit erred in holding,† in effect, that one who has presumably invented a better coupler can claim (as an allegedly new "*combination*") the use of **old** grease-cups and **old** pumps with his presumably improved coupler.

5) The Court of Appeals for the Seventh Circuit erred in holding,‡ in effect, that a patentee may use the patent laws to prevent the competitive sale of **old** and unpatentable grease-cups (or so-called "*nipples*") which may be usable, or indeed intended to be used with the patentee's allegedly improved and patentable coupler, as assertedly manufactured by plaintiff.

6) The Court of Appeals for the Seventh Circuit erred in holding,‡ in effect, that the owner of the patent* can extend the monopoly of a so-called "*combination*" claim (drawn to an improved device plus two **old** devices), to pre-

* Assuming (without conceding) for the purposes of this issue, that the patent owner (plaintiff-respondent here) manufactures and sells, and gives wide distribution to a coupler in reality responding to the coupler-part of the claim-language. (The Court of Appeals for the Eighth Circuit in *Stewart-Warner v. Jiffy* (81 Fed. 2d 786) held that respondent's coupler was **not** the coupler of the Butler patent.)

† this holding of infringement, by the *conjoint use* of the patentee's improved coupler with the defendant's **old** grease-cup, is also in direct conflict with this Court's decision on Gullborg claims 1 to 10 in the case of *Rogers v. Alemite* (298 U. S. 415).

‡ in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of *Rogers v. Alemite* (298 U. S. 415).

vent the use of an old-style grease-cup or so-called "nipple" of competitive manufacture, with a coupler assertedly in accordance with the patent and manufactured and sold by the patent owner and with an old-style pump, also supplied by the patent owner.

7) The Court of Appeals for the Seventh Circuit erred in holding,† in effect, that a patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, can re-patent the old combination by re-claiming the combination with the improved element substituted for the old element.

8) The Court of Appeals for the Seventh Circuit erred in holding, that the multi-jawed "chuck" type coupler purported to be defined in the coupler-part of the Butler claim-language is patentably distinct from, or represents a patentable improvement or invention over the multi-jawed "chuck" type couplers of the prior-art.

9) The Court of Appeals for the Seventh Circuit erred in failing to reverse the decree of the District Court.

10) The Court of Appeals for the Seventh Circuit erred in not dismissing the bill of complaint for want of equity.

11) The Court of Appeals for the Seventh Circuit erred in denying defendant's petitioner's petition for re-hearing.

† in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of *Rogers v. Alemite* (298 U. S. 415).

SUMMARY OF ARGUMENT.

The points of the argument hereinbelow follow the reasons relied upon for the allowance of the writ, as outlined in pages 19 to 24 of the Petition for Writ of Certiorari, and are briefly:

Argument Point 1:

The coupler part of the Butler claim-language, construed in the light of the applicable portions of the specification and drawings of the Butler patent ¹

and/or

construed in the light of the prior art so as in some way to be distinguishable over the prior art hose couplers

is **not** readable on and does **not** cover the respondent's commercial form of coupler, sometimes referred to as the "Alemite Hydraulic" coupler, in **conjoint use with which** petitioner's grease-cup is **charged contributorily to infringe**, and (as held by the United States Circuit Court of Appeals for the Eighth Circuit, in respondent's suit against Jiffy Lubricator Co., 81 Fed. 2d 786) respondent's said commercial form of hose coupler here involved is **not** in fact the coupler of the Butler patent.

Argument Point 2:

A patentee may not re-monopolize old-style grease-cups on the basis of an asserted improvement in a hose coupler ² usable therewith.

¹ Figure 2 of the Butler drawings, and the corresponding parts of the specification beginning in line 87, of page 2 of the Butler specification (R. p. 468), down to line 5 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

² The hose coupler improvement may, for the purposes of this point of the argument, be assumed to be a patentable hose coupler.

Argument Point 3:

The Butler claim in suit is invalid or unpatentable because drawn to an old and exhausted combination of pump, grease-cup and coupler, whereas the patentee's improvement (if any), is at best merely in the internal construction or mechanism of the coupler. The construction and mode of operation of the old "combination" of pump, grease-cup and coupler, is otherwise unchanged.

The Butler claim in suit violates Section 4888 of the Revised Statutes in that the patentee has **commingled** in the patent claim

(a) that which may be his (the improved coupler)
with

(b) that which is in the public domain (old-style grease-cup and old-style pump);—

the Statute requiring, inter alia, that the patentee "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery".

Argument Point 4-a:

Section 3 of the Clayton Act prohibits the monopoly such as herein asserted by respondent, and respondent may **not** restrict the use of the assertedly Butler-improved coupler of its own manufacture, to its periodic attachment solely to grease-cups of its own manufacture, (to the exclusion of grease-cups manufactured and sold by petitioner);—notwithstanding respondent's ownership of a patent assertedly covering its coupler in so-called "combination", broadly, with any old grease-cup;

or otherwise stated:

Respondent may **not** impose as a condition of sale of its assertedly Butler-improved couplers, that the purchasers shall not use the same in conjunction with old-style grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved coupler in so-called "*combination*" with an old-style grease-cup. Such condition of sale violates Section 3 of the Clayton Act.

Argument Point 4-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-improved "*Alemite Hydraulic*" couplers are impliedly licensed to use the same with any old-style and unpatentable grease-cups including those of petitioner.

STATUTES.

The statute under which this case arises and which is necessary to be considered, is section 4886 of the Revised Statutes (U. S. C. Title 35, Sec. 31). That statute reads as follows:—

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to

have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 4888 of the Revised Statute (U. S. C. Title 35, Sec. 33) is also involved in the case, and is as follows:—

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and **he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.** The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and also involved in the cause, is as follows:

"That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular pos-

session or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce."

ARGUMENT OF POINT I.

Petitioner's old-style (and unpatented) grease-cup or so-called "nipple" or "fitting"

cannot possibly constitute "*contributory*" infringement as charged, because

respondent's own commercial "**Alemite Hydraulic**" coupler (in conjoint use with which petitioner's unpatentable grease-cup or "nipple" is charged "*contributorily*" to infringe) is not in fact the Butler coupler because not "**according to the drawing or specifications on which the claim in suit read**", quoting from the Circuit Court of Appeals for Eighth Circuit in respondent's earlier suit against Jiffy Lubricator Co. (81 Fed 2d 786, 788).

One of the separate and distinct defenses of non-infringement in the case at bar is that respondent's commercial "**Alemite Hydraulic**" coupler is **not**, in fact, the Butler coupler. If that is true then non-infringement is conclusively established in the case at bar on that one ground alone, irrespective of the other defenses of non-infringement and invalidity covered by the other Argument of Points in this brief.

Thus, if plaintiff-respondent's own commercial "Alemite Hydraulic" coupler is **not** the coupler of the Butler claim, then the conjoint use therewith of defendant-petitioner's grease-cup or "nipple" can **not** constitute direct infringement. In the absence of such direct infringement, there can be no contributory infringement (*Popular Mechanics v. Brown*, 245 Fed 859, 860, CCA 7).

In the Jiffy case, the Circuit Court of Appeals for the Eighth Circuit held that plaintiff-respondent's "Alemite Hydraulic" coupler is **not** the coupler defined by the coupler part of the Butler claim-language for the reason that the coupler part of the claim-language requires that the nipple-engaging means (the three radially-movable locking jaws 40) be **compressively** actuated. The only means of "compression" disclosed, are Butler's **resilient spring fingers 42**, which do subject the radially-movable locking jaws 40 to **spring-compression**. Plaintiff-respondent's commercial "Alemite Hydraulic" couplers do **not** have **any** such spring fingers nor any other resilient or spring-like or "**compressive**" jaw-actuating means. Instead, the jaws of the "Alemite Hydraulic" coupler are actuated by an unyielding cam or wedge surface.

The Court of Appeals for the Eighth Circuit in respondent's suit against Jiffy Lubricator Co. (81 Fed 2d 786), affirming the trial court, correctly held that **neither** the Jiffy coupler, nor indeed respondent's own commercial "Alemite Hydraulic" coupler responded to the coupler-part of the Butler claim-language for the above-outlined reason.

The coupler parts of Butler claims 1 and 2 are indistinguishable in substance as shown by the parallel columns of the **coupler-parts** of Butler claims 1 and 2, on pages 28 to 30 of this brief and on the Summary Chart facing this page.

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CHART

Summarizing the conflict between the decision of the Circuit Court of Appeals in the case at bar and:

- 1) decision of Court of Appeals for the Eighth Circuit in Stewart-Warner vs Jiffy (81 Fed. 2d, 786) as to the scope of the coupler-part of the B
- 2) decision of this Court in Rogers vs Alemite (298 U. S. 415) as to right of an alleged inventor of an improved coupler, to monopolize old grea

Center column contains the entire Butler Claim 2 in suit. The column directly to the left of the center contains the entire Butler Claim 1, adjudicated in the Jiffy case. The column directly to the right of the c
The apertured sealing seat (washer 51) of Butler's coupler, and which is element numbered 4 in the Butler claim analysis below, is the same as Gullborg's "perforated sealing disc" wh

This Court held that the patentee can not monopolize the grease-cup and old pump. ("Respondent says that as pin fittings made in accordance were sold by petitioner . . . We are of the op patent in suit to prove the patent in suit" 29

The C C A 8 held that respondent's "Alemite Hydraulic" coupler (in conjoint use with which petitioner's accused grease-cup or so-called "nipple" is charged contributorily to infringe) is not "according to the drawing or specifications on which the claim in suit reads" (81 Fed. 2 789). The coupler part of both Butler claims is substantially the same.

| THE DEVICES. | The definition of devices "A" and "B" in the claims is merely a generic and all-inclusive reference to the entire class of each of the two devices. | BUTLER CLAIM 1. Adjudicated by C C A 8 (81 Fed. 2 786). (Certiorari denied 299 U. S. 554.) | BUTLER CLAIM 2 IN SUIT. Held invalid at 15 F. Supp. 410 on authority of 298 U. S. 415. | GULLBORG CLAIM Adjudicated at 298 U |
|--------------|---|--|---|--|
|--------------|---|--|---|--|

"The combination with" "The combination with" "The combination with" A.....

Device A— An old grease-cup or so-called lubricant-receiving.... "a nipple for receiving lubricant, of"..... "a headed nipple for receiving lubricant, of".... "a hollow coupling member havin ing from one side thereof pressed closure, of" (a grea

Device B— { An old pump or grease-dispensing "compressor")... "a lubricant compressor having"..... "a lubricant compressor having".... "a pump", Butler's "lubricant compressor" also includes a discharge conduit. (Butler's "lubricant compressor" also includes a discharge conduit.) (Butler's "lubricant compressor" also includes a discharge conduit.) "a discharge conduit having one the outlet of said pump",

"a coupling for connecting said compressor..... "a coupling member for connecting said com-.... "a second coupling member (a cou the closed end of said first member (the closed end of the secured (that is, the coupler is an end of said conduit and (coupler elements 1 to 5 below) "comprising" (coupler elements 1 to 5 below)

- 1) "a cylinder" (parts 31 & 32 in Figure 2 con-.... 1) "a cylinder (parts 31 & 32 in Figure 2 con-stituting the body or housing of the
- 1) "a bayonet slot adapted to pin"

of the Butler claim-language, and
old grease-cups usable therewith.

t of the center contains the entire Gullborg Claim 2, adjudicated by this Court in Rogers vs Alemite.

disc" which is element numbered 2 in the Gullborg claim analysis below.

rease-cup or so-called "fitting" or "nipple" intended for use with the improved coupler
accordance with the prior art, but susceptible of use with a gun covered by the patent in suit,
petitioners, these sales constituted contributory infringements of all the claims of the patent.
of the opinion that the owner of patents . . . cannot extend the monopoly of the combination
to prevent the use of a pin fitting . . . with a gun having a coupler such as that claimed in
suit" 298 U. S., 424, 425).

RG CLAIM 2.

at 298 U. S. 415.

**THIS COURT'S DEFINITION OF THE
GULLBORG DEVICES.**

(298 U. S. 419.)

THE DEVICES.

as referred to by
this Court at 298
U. S. 419.

ber having a pin project-.... "a type of pin fitting which was old in the art".... Device 1
thereof and a spring- (a grease-cup) ..
" (a grease-cup)

..... "a pump for creating pressure, which was old".... Device 2

ving one end secured to.... "a hose to connect the two; and" Device 3
pump",

er (a coupler) for receiving....
aid first named coupling
d of the grease-cup or "nipple")
upler is secured) to the other
uit and provided with"
1 to 4 below)

ted to co-act with said....

Device C. Butler's allegedly new and improved hose-coupler...
 of Figure 2 of drawings only.

The Court of Appeals for the Eighth Circuit held that respondent's commercial "Alemite Hydraulic" coupler is not the coupler here defined, and that the coupler here defined was never produced or sold by respondent.

- | | | |
|--|--|--|
| <p>1) "a cylinder" (parts 31 & 32 in Figure 2 constituting the body or housing of the coupler).</p> <p>2) "a piston (43 & 45) movable within the cylinder, and having</p> <p>3) "an aperture (48) for the discharge of lubricant therethrough," "and"</p> <p>4) "an apertured seat" (washer 51) "for engagement with the end of the nipple,"</p> <p>5) "means (jaws 40) carried by the cylinder" "for compressively engaging" about the nipple" "for locking said parts together against longitudinal displacement and" "actuated by said piston". (43 & 45 + 42) (given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).</p> <p>"whereby the pressure of the lubricant on said piston¹ will move the piston¹ to forcibly compress² said means (jaws 40) while the lubricant is passing through said connecting parts."</p> | <p>1) "a cylinder (parts 31 & 32 in Figure 2 constituting the body or housing of the coupler).</p> <p>2) "a piston (43 and 45) movable within the cylinder, and having</p> <p>3) "an aperture (48) for the discharge of lubricant thereof"</p> <p>4) "an apertured sealing seat (washer 51) carried by said piston" "for engagement with the end of the nipple," "connecting the piston aperture with a passage through the nipple,"</p> <p>5) "radially movable locking elements (jaws 40) carried by the cylinder coacting with the nipple and "actuated by said piston" (given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).</p> <p>"for compressively clutching" the elements upon the nipple"</p> <p>"whereby the pressure of the lubricant on said piston¹ will move the piston¹ to forcibly compress² said means (jaws 40) while the lubricant is passing through said connecting parts."</p> | <p>1) "a bayonet slot adopted to co pin"</p> <p>2) "a perforated sealing disk mounted in the bore of said coupler"</p> <p>3) "means for yieldingly urging against the closed end of a coupling member (said "nipple"), and</p> <p>4) "means for limiting the movement of said disk in the direction of the coupling member."</p> |
|--|--|--|

1) The piston (43 & 45 + 42) within the coupler.
 2) By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45.

a coupler) for receiving....
first named coupling
of the grease-cup or "nipple")
is secured) to the other
and provided with"
o 4 below)

l to co-act with said....

ak mounted to recipro....
id coupling member",

rging said sealing disk....
d of said first named
against the grease-cup or

a coupler found by this Court to be novel and to
be actually produced and sold by re-
spondent.

Device 4

movement of said seal....
ection of said second

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PAGE

The Court of Appeals for the Eighth Circuit held that respondent's own "Alemite Hydraulic" coupler (in joint use with which petitioner's grease-cup or so-called "nipple" is charged *contributorily* to infringe) is not "according to the drawing or specifications on which the claim in suit reads" (81 Fed 2d 789). The coupler-language of both Butler claims is substantially the same.

To show what was before the Court of Appeals for the Eighth Circuit in the Jiffy case and what that Court decided, petitioner in the case at bar introduced in evidence (R. pp. 98, 99, 403) a drawing of respondent's own commercial coupler (or so-called "Alemite Hydraulic" coupler) referred to in the Opinion of the Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). This Court also has available the entire record in the Jiffy case, as that record was filed in this Court by respondent with its own petition to this Court in the Jiffy case (No. 114, Oct. Term, 1935; certiorari denied 299 U. S. 554).

Respondent's commercial form of coupler (the so-called "Alemite Hydraulic" coupler) which the Court of Appeals for the Eighth Circuit in the Jiffy case held not to be the coupler of the Butler patent and to be outside the scope thereof, is identically the same as respondent's commercial "Alemite Hydraulic" coupler in the case at bar (in joint use with which the petitioner's accused grease-cup or "nipple" is charged "*contributorily*" to infringe).

Respondent's own "Alemite Hydraulic" coupler is also substantially identical with the exculpated Jiffy coupler. The Court of Appeals for the Eighth Circuit not only held the Jiffy coupler to be outside the scope of the Butler patent, but also clearly and expressly and necessarily excluded respondent's "Alemite Hydraulic" coupler from the scope

of the Butler patent. This exclusion of plaintiff-respondent's own "Alemite Hydraulic" coupler from the scope of the Butler patent follows both from the fact that it is substantially identical with Jiffy's accused and exculpated coupler*, as well as from the Court's statements in its Opinion (81 Fed 2d 786).

The Court of Appeals for the Eighth Circuit was indeed compelled specifically to pass upon respondent's own so-called "Alemite Hydraulic" coupler for the reason that respondent represented the commercial success of its own "Alemite Hydraulic" coupler as one of the reasons why Butler Claim 1 should be given the broad interpretation necessary for respondent's success in that suit, and also because respondent urged upon the Court of Appeals for the Eighth Circuit that the coupler part of Butler Claim 1 should be given a broad enough interpretation to make the Jiffy coupler an infringement, for otherwise respondent's own "Alemite Hydraulic" coupler would of necessity be outside the scope of its own Butler patent. In **Appendix I** appended to this brief we have excerpted the pertinent portions from respondent's briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). These excerpts further show just what the respondent at bar did urge upon that Court as to the scope of the Butler patent.

The Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) flatly denied respondent's contentions as to the scope of the Butler patent and clearly divested Butler of any vestige of inventorship with respect to respondent's own commercial "Alemite Hydraulic"

*The substantial identity of the Jiffy coupler and the "Alemite Hydraulic" coupler was asserted and urged in the Jiffy case by respondent.

coupler (in conjoint use with which petitioner's old grease-cup or "nipple" is charged "*contributorily*" to infringe in the case at bar). The Court of Appeals for the Eighth Circuit said:

"The plaintiff has **not** made or sold **any** coupler constructed according to the above drawing and specifications of its Butler patent, **nor** had it made or sold **any** couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple **until long after it had received examples of the defendants so-called Jiffy lubricator.**"

(81 Fed 2d 786, 788.)

"the plaintiff had **not** manufactured for sale **any** couplers according to the drawing or specifications on which the **claim** in suit reads"

(81 Fed 2d 786, 788.)

"The claim that Butler accomplished a new and useful result in the industry and therefore is entitled to broad protection (Smith v. Snow, 294 U. S. 1. 14, and cases there cited) is **without** merit. As was said in Dernel Potato Products Co. v. Snelling, (CCA 2) 38 Fed 2d 788, 789:

"The appellant's* patent has not been put to **commercial use**, and, therefore, it is not entitled to a construction of any broader scope than it is clearly required to be given.' "

(81 Fed 2d 786, 793.)

The Court of Appeals for the Seventh Circuit in the case at bar erroneously rejected the conclusion reached by the Court of Appeals for the Eighth Circuit with respect to the scope of the Butler patent and held, in **conflict with the Eighth Circuit**, that respondent's own commercial "Ale-

*Respondent. at bar.

mite Hydraulic" coupler did embody Butler's coupler invention.

In **Appendix II** appended to this brief, we have reproduced pages 49 to 54 inclusive of the court reporter's transcript of respondent's oral argument before the Circuit Court of Appeals for the Seventh Circuit in the case at bar (not reproduced in the record), wherein respondent's counsel, Mr. Williams, admitted to that Court (responsive to Judge Evans' pointed question) that in order for respondent to prevail in the case at bar it was necessary for that Court "to reach a different conclusion" from that reached by the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case with respect to the scope of the Butler patent.

Respondent's own commercial "Alemite Hydraulic" coupler is **not** in fact the coupler defined in the coupler part of the Butler claim-language, for the reason relied upon by the Court of Appeals for the Eighth Circuit, whose decision (81 Fed 2d 786) is in and of itself sufficiently clear and cogent to make it unnecessary for us to argue this point beyond reliance upon said decision (81 Fed 2d 786) and the authorities cited therein.

The Chart facing page 52 further serves to show the identity of the issues involved in the case at bar and in the Jiffy case with respect to the scope of the Butler patent and the conflict of opinion of the two Circuits (7th and 8th) with respect to the scope of the Butler patent.

We submit that the decision of the Court of Appeals for the Eighth Circuit as to the scope of the Butler patent is correct, and that the decision of the Court of Appeals for the Seventh Circuit in the case at bar with respect to the scope of the same patent is erroneous and should be reversed by this Court.

ARGUMENT OF POINT II.

A patentee may not monopolize what he did not contribute. Specifically a patentee may not re-monopolize an old-style grease-cup or so-called "nipple" or "fitting" on the basis of an asserted improvement in a hose-coupler usable therewith.

In patent cases, this Court has always looked through the verbiage of patent claims, and has determined what it was (if anything) that the patentee invented. This Court has always, in effect, asked the question: What did the patentee contribute? If the answer is "Nothing", then the patent cannot be valid, because the statutory requirement for the granting of a patent has not been met.

If the answer to the above question be, "He made a new coupler", then the patentee's monopoly is in a coupler, and in nothing else, since the statutory provision is that the monopoly shall be for limited times upon what the patentee has contributed, and not upon what someone else invented or upon what was already known.

The Common Denominator of This Court's Decisions on Contributory Infringement.

The searching inquiry which this Court makes in every patent case does not stop at the mere words that are put together as a patent claim, and which often go far beyond the invention in their inclusiveness. This Court in every case, according to the facts and the law, penetrates through patent claim language, and decides upon what monopoly the patentee is entitled, according to what the patentee contributed.

Petitioner's position in this suit is in harmony with each of this Court's four leading decisions on contributory infringement. These decisions are:—

Leeds & Catlin Company v. Victor Talking Machine Company, 213 U. S. 301 and 325;

Carbice Corporation of America v. American Patents Development Corporation, et al., 283 U. S. 27;

Leitch Manufacturing Company, Inc., v. The Barber Company, et al., 302 U. S. ; and

Rogers, et al. v. Alemite Corporation, 298 U. S. 415.

The common denominator of this Court's four above-cited decisions is that where the defendant appropriated the thing which the patentee in reality contributed, then the defendant trespassed upon the patentee's rights; and where the defendant did not appropriate the thing which the patentee in reality contributed, then the defendant did not trespass upon the patentee's rights.

Thus, while the theory of contributory infringement may be applicable to prevent a defendant from appropriating the patentee's actual contribution to the art, as in the Leeds and Catlin case, it is entirely inapplicable to prevent a defendant from using things long old in the art as in the Carbice, Leitch, and Rogers cases.

Thus, the theory of contributory infringement, as pointed out by this Court in the three cases last above mentioned, cannot be used by a patentee to gain a monopoly of old materials, articles or devices.

In the patent in the Leeds & Catlin suit, the invention was distinguished by the phonograph disc record. At 213 U. S. 325, at 330, this Court said:

"It will be observed how important the record is to the invention embodied in the claims. It is the undulations in the side walls of the spiral groove which vibrate the stylus back and forth, transmitting the recorded sound waves to the diaphragm, at the same time propelling the stylus as it engages with the record. If

a comparison may be made between the importance of the elements, as high a degree (if not a higher degree) must be awarded to the disc with its lateral undulations as to the stylus. **It is the disc that serves to distinguish the invention,—to mark the advance upon the prior art."**

And in 213 U. S. on page 335, the Court said:

"Indeed, as we have seen, it is the distinction of the invention, constituting, by its laterally undulating line of even depth and the effect thereof, the advance upon the prior art."

In Leeds & Catlin the defendant sought to appropriate Berliner's disc record which the Supreme Court said was **new** and marked "the advance upon the prior art."

On the other hand, in the case at bar, the defendant is not making any coupler complained of, but is making an *old* grease-cup or so-called "fitting" or "nipple" for use, inter alia, with plaintiff's old pump and allegedly Butler-improved coupler.

It will thus be seen that in Leeds & Catlin, Berliner had, inter alia, a disc-type phonograph record which in and of itself was new and theretofore unknown* both per se and in its effect in the combination. Berliner claimed such **new phonograph record** in combination with the phonograph machine. **Leeds & Catlin appropriated** that part of the claimed combination constituted by **such new phonograph record**.

Thus, although Berliner's form of claim may or may not have been proper,† Berliner's assignee was permitted to reach the trespasser upon Berliner's **new record**.

* That is, a disc record with a generally spiral groove of uniform depth having lateral "sound" undulations therein and capable of both vibrating the stylus of the sound reproducer on a phonograph and also capable of propelling that stylus across the face of the record.

† Whether proper or improper, it was not necessary there to decide.

In the Carbice case, 283 U. S. 27, the patentee had invented a container, and the Carbice Corporation was charged with contributory infringement because it sold its product with knowledge that it was to be used by the purchaser in transportation packages like those described in the patent. The defendant was not charged with making or selling packages but with making or selling solid carbon dioxide (dry ice). This Court said at page 29:

“The patent in suit is not for solid carbon dioxide. That article and its properties as a refrigerant have been long known to the public.”

At pages 30 and 31:

“The invention claimed is for a particular kind of package employing solid carbon dioxide in a new combination. If the patent is valid the owner can, of course, prohibit entirely the manufacture, sale, or use of such packages”.

This Court therefore held that the defendant had not infringed, stating at page 33:

“The Dry Ice Corporation has no right to be free from competition in the sale of solid carbon dioxide. Control over the supply of such unpatented material is beyond the scope of the patentee's monopoly; and this limitation, inherent in the patent grant, is not dependent upon the peculiar function or character of the unpatented material or on the way in which it is used. Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention.”

In the Leitch v. Barber case, 302 U. S. , the patentee contributed a method of practicing road building, and the defendant, with knowledge of the use to which it was to be

put, supplied to the road builder, for the purpose of practicing the method, an unpatented material necessary to carry out the method. This Court said, at the last paragraph of the Leitch decision, in referring to the Carbice case:

"By the rule there declared every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly. Nothing in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 325, limits it".

In the *Rogers v. Alemite* case, 298 U. S. 415, precisely as in the case at bar, defendant made only the generally-old, prior-art devices and not any device embodying that which constituted the real improvement (if any) of the patent in suit.

In the *Hollingshead* case, and in the *Rogers* case, defendant made an old prior-art grease pump and old bayonet coupler, *for use with* the Gullborg-improved grease-cups or so-called "fittings" or "nipples" sold by plaintiff, and when Hollingshead's and Rogers' grease pump and coupler were so used with plaintiff's grease-cup "fitting" or "nipple", the entire combination of Gullborg claims 14 and 15 was brought into being.

Similarly, in the *Rogers* case, as also in the case at bar, defendant manufactured and sold a generally old prior-art grease-cup or so-called "fitting" or "nipple" specifically dimensioned *for use with* an old pump and a new improved coupler, and when used, the entire combination of the allegedly infringed claims was brought into being.

In the Rogers case, these were claims 1-10, of the Gullborg patent.

This Court expressly said in the Hollingshead and Rogers cases that one inventing an improved coupler cannot monopolize the grease cups or so-called "fittings" or "nipples" which are to be used with it:

the patent owner "cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting * * * with a gun having a coupler such as that claimed in the patent in suit." (298 U. S. 415, 425.)

From the above, it is clear just what this Court has done in all of these four cases. In every instance this Court has actually determined where the invention was, and has, on that basis, either held the defendant guilty or not guilty, depending on whether the defendant did or did not make the thing which constituted the patentee's contribution.

On the authority of this Court's decision in *Rogers v. Alemite*, we submit that Butler's invention (if any) is in the internal construction or mechanism of a coupler. Since the petitioner has not been accused of making or selling any couplers, the petitioner has not trespassed on the respondent's rights.

A patentee may not re-monopolize an old-style grease-cup on the basis of an asserted improvement in a hose-coupler usable therewith.

Precisely this point was decided against this respondent in *Rogers v. Alemite*, 298 U. S. 415, 425, upon a state of facts as identical with the state of facts in the case at bar, as the state of facts could ever be alike in any two patent infringement suits based upon two different patents.

If anything, the facts in the case at bar are even less favorable to respondent's position than were the corresponding facts in its *Rogers v. Alemite* case.

Thus, in its earlier *Rogers v. Alemite* suit, the Gullborg coupler was not only found to be improved and patentable but was in reality manufactured and widely distributed by respondent.

In the case at bar, however, respondent has clearly not manufactured or sold any coupler in accordance with the Butler patent, as held by the Circuit Court of Appeals in respondent's earlier Jiffy suit (81 Fed 2d 786; certiorari denied 299 U. S. 554).

The facts in the case at bar are also less favorable to respondent than were the corresponding facts in the *Rogers v. Alemite* case, for the further reason that while in the *Alemite* case Gullborg's improved coupler was claimed to have *done* something new to the old-style (bayonet or "pin-fitting" type) grease-cup there sought to be re-monopolized,

that is, ostensibly "sucking" the slight excess of grease off the end of the grease-cup upon the disunion of the coupler therefrom and so "cleansing" the grease-cup;—

there is not even the remotest suggestion in the case at bar that Butler's assertedly improved coupler *does* anything new to the old-style "headed" grease-cup or "nipple" sought to be re-monopolized in the case at bar.

Thus, while Butler's assertedly improved coupler may be asserted to grip or grasp or seal better than the other multi-jawed "chuck" type couplers of the prior-art, there is not the remotest suggestion that anything new happens to the old style "headed" grease-cup or "nipple" when assertedly better grabbed or gripped or sealed by the Butler coupler.

Thus, the question in the case at bar, just as in *Rogers v. Alemite* (298 U. S. 415), is whether a patentee may re-monopolize an old-style grease-cup, merely because he has allegedly invented an assertedly improved coupler usable therewith (in place of the coupler of the prior-art theretofore used with such old-style grease-cup).

Stating the question in a different way: whether an inventor of an improved and presumably patentable coupler can also have a monopoly on all the old-style headed grease-cups, "fittings" or "nipples" with which his improved coupler is adapted to be used and must necessarily be used, even assuming that such assertedly improved coupler grips or grabs the old-style grease-cup better than it had theretofore been gripped or grabbed by the prior-art couplers, and even assuming that the patentee's improved coupler makes a better fluid-seal than did the prior-art hose-couplers.

This is indeed a fundamental question of patent law because if the patentee of an improved coupler can also have a monopoly of the old-style grease-cup, "fitting" or "nipple" with which his coupler would normally be used, then the same old grease-cup "fitting" or "nipple" can be re-monopolized for as many successive seventeen-year periods as there can be improvements in couplers.

Thus, for instance, the very "bayonet" type grease-cup or so-called "pin-fitting" which this Court said could not be re-monopolized under claims 1, 2, 3, 4 and 8 of Gullborg patent No. 1,307,734 (298 U. S. 415), could then, under respondent's theory of the case at bar be re-monopolized under its much more recent Butler patent here in suit.

Thus, in the *Jiffy* case (81 Fed 2d 786) the old and heretofore much litigated (298 U. S. 415) "bayonet" type

grease-cup or so-called "pin-fitting" was indeed asserted by respondent to be the grease-cup or "nipple" element of its more recent Butler claim 1.

Thus, as Butler claim 1 does not call for a "headed" nipple but merely a "nipple for receiving lubricant", and as multi-jawed "chuck" type couplers can be and are also made with smooth-surfaced gripping jaws (as for instance, Jiffy's accused coupler) for gripping the smooth side-wall of the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting", it would only be necessary under respondent's theory of the case at bar, that respondent should manufacture and widely distribute in the field a real Butler coupler of the diameter of the Jiffy coupler for use with the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting". Thereafter, the competitive manufacture and sale by others of the old "bayonet" type grease-cups or so-called "pin-fittings"

either of the form of the now-expired Gullborg patents Nos. 1,307,733 and 1,307,734 (298 U. S. 415),

or of the still older form known prior thereto (and which this Court said respondent could not re-monopolize under its Gullborg patent 1,307,734),

could again be charged to constitute "contributory" infringement of the Butler patent, under respondent's theory of the case at bar;—because such old "bayonet" type grease-cups or so-called "pin fittings" would then become the "nipple" of Butler claim 1, just as much as petitioner's herein-accused old-style headed grease-cup is allegedly the "nipple" of Butler claim 2 in the case at bar.

The trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar confused two different kinds of "combinations", that is,

- 1) the combination of mechanical elements which compose or constitute, or go to make up the one device assertedly improved by the patentee, that is, the coupler,

and

- 2) the so-called "*combination*" between (or what in reality is, merely the conjoint use of) the patentee's assertedly improved coupler and the old-style grease-cup and old-style pump;—with which his assertedly improved hose-coupler must necessarily be used in order to have utility.

Thus, while Butler may have invented* a novel combination of coupler-composing elements (constituting an improved coupler), he did not invent any "*combination*" of grease-cup, pump and coupler, because grease-cups, pumps and couplers had been used or "*combined*" with each other long before Butler in the same way that Butler "*combined*" them.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously failed to distinguish between the possible patentability of a new combination of coupler-composing elements on one hand, and the manifestly unpatentable old "*combination*" of grease-cup, pump and coupler, on the other hand;—the latter old *combination* not being rendered "*new*" merely by substituting an improved coupler for the old coupler.

The decision of both the trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar is manifestly erroneous on the question of law here involved,

*Just as did Gullborg in the Bassick-Alemite cases (296 U. S. 415).

as can be shown by the simplest and plainest application of the language of this Court's opinion in the *Rogers v. Alemite* case, to the precisely parallel facts of the case at bar.

The controlling effect of this Court's decision in *Bas-sick v. Hollingshead* and *Rogers v. Alemite* (298 U. S. 415, 424, 425) upon the questions at bar, is clear from the following quotation from page 425, wherein we have inserted parenthetically certain explanatory terms:

"It is plain that Gullborg (and likewise Butler) . . . invented an improved form of (*grease-delivery*) coupler to be attached to the end of the hose leading from the (*old*) pump to the (*old*) fitting (*the grease-cup or 'nipple'*). Instead of patenting this, . . ., he claimed a combination of pump, hose-coupler, and pin-fitting, ('headed' instead of 'pin' in the case of Butler), and embodied in the combination his improved form of (*grease-delivery*) coupler."

This Court then further said:

"The question then is whether, by this method, the patentee, by improving one element (*or one device, as for instance, the hose-coupler*) of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element (*his improved coupler device*) substituted for the old element (*the old prior-art coupler*). That this cannot be done is shown by numerous cases in this and in other federal courts".

This Court then further went on to say:

"We are of the opinion that the owner of the patents . . . cannot extend the monopoly of the combination patent in suit to prevent the use of a (*old*) pin-fitting (*headed fitting or 'nipple' in the case of Butler*) which

does not infringe the fitting patent, 1,307,733 (*that is, a pin-fitting or grease-cup or 'nipple' of the prior art*) with a gun (or pump) having a (*grease-delivery*) coupler such as that claimed in the patent in suit."

Thus, to paraphrase the above-quoted language of this Court in the *Rogers v. Alemite* case, to apply it to the case at bar, it is merely necessary to substitute the name "Butler" instead of the name "Gullborg", and to change the word "pin" to the word "headed".

The above quoted decision of this Court in the *Rogers v. Alemite* case was properly deemed absolutely controlling by the District Court for the Western District of Pennsylvania in respondent's two suits against the same *Rogers* and against the Universal Lubricating Systems Inc. and others, in which suits the decision is reported at 15 F. Supp. 410. The District Court said in its Findings of Fact (not published):—

"11. The alleged novelty and improvement, if any, of each of the patents in suit is in the mechanism or construction or structural characteristics of the particular coupler or nozzle disclosed in each patent.

"12. The construction and operation of the old combination or system of: (a) nipple; (b) pump; (c) coupler or nozzle is not changed by the allegedly novel or coupler improvement of the respective patents in suit.

The absolute parallelism between the facts of the case at bar and the facts involved in *Rogers v. Alemite* (298 U. S. 415) can best be shown from the following comparative columns:—

In the Case at Bar:

Butler made an alleged improvement in the internal construction or mechanism of an otherwise *old* "chuck" type (multi-jawed) coupler for making perhaps a better "chuck-coupled" connection between

- 1) the *old* "headed" type grease-cup or "nipple" or "fitting" of the prior art
and
- 2) the *old* grease pump, compressor, or "grease-gun" of the prior art.

Butler (in his claims) claims his specific and allegedly improved "chuck" type coupler in so-called "*combination*" with

the *old* "headed" type grease-cup or "nipple" or "fitting" of the prior art
and

the *old* pump or compressor of the prior art.

In the Rogers vs Alemite Case:

Gullborg made an improvement in the internal construction or mechanism of an otherwise *old* "bayonet" type-coupler for making perhaps a better "bayonet-coupled" connection between

- 1) the *old* "bayonet" type grease-cup or "nipple" or "fitting" of the prior art
and
- 2) the *old* grease pump, compressor, or "grease-gun" of the prior art.

Gullborg claimed his specific and allegedly improved "bayonet" type coupler (in claims 1, 2, 3, 4, & 8 in issue) in so-called "*combination*" with

the *old* "bayonet" type grease-cup or "nipple" or "fitting" of the prior art
and

the *old* pump or compressor of the prior art.

In the Case at Bar:

Respondent, under its later Butler patent here in suit, charges *contributory* infringement, by reason of defendant-petitioner's sale of old and unpatented "headed"-type grease-cups, "fittings" or "nipples" of the prior art, merely because such old grease-cups were adapted and intended for use, *inter alia*, with the *allegedly** Butler-improved "chuck" type couplers manufactured and sold by plaintiff-respondent.

In the case at bar plaintiff-respondent charges **no** infringement of Butler claim 2 by defendant-petitioner's manufacture or sale of **any** couplers (or pumps), even though the asserted novelty of the Butler claim is predicated solely upon the particular internal construction of the coupler;—the **only** one of the several separate

In the Rogers vs Alemite Case:

Respondent, under its earlier Gullborg patent, charged *contributory* infringement, by reason of defendant-petitioner's manufacture and sale of old and unpatented bayonet-type grease-cups, "fittings" or "nipples" of the prior art, merely because such old grease-cups were adapted and intended for use, *inter alia*, with the Gullborg-improved bayonet-type couplers manufactured and sold by plaintiff-respondent.

In the Rogers vs Alemite case respondent charged **no** infringement of Gullborg claims 1, 2, 3, 4, & 8, by petitioner's manufacture or sale of **any** couplers (or pumps), even though the asserted novelty of these claims was predicated solely upon the particular internal construction of the coupler;—the **only** one of the several separate and

* See explanation on page immediately following these parallel columns.

In the Case at Bar:

and distinct devices included in the Butler claim which is specifically defined therein in terms to distinguish it from the corresponding prior-art device.

The sole charge of infringement in the case at bar is levelled at defendant-petitioner's old and unpatented grease-cup or so-called "fitting" or "nipple", which is one of the several separate and distinct devices included in Butler claim 2, without, however, any specific definition thereof in this claim;—the grease-cup or "nipple" being defined in the claim merely in broad and all-inclusive terms not distinguishing from the grease-cups or "nipples" of the prior art.

Plaintiff-respondent's theory of infringement (levelled at defendant-petitioner's old and unpatented grease-cup), in the case at bar, is that when one of

In the Rogers vs Alemite Case:

distinct devices included in these Gullborg claims which was specifically defined therein in terms to distinguish it from the corresponding prior-art device.

One of the two charges of infringement in *Rogers vs Alemite*, was levelled at petitioner's old and unpatented grease-cup or so-called "nipple" or "fitting", which was one of the several separate and distinct devices included in Gullborg claims 1, 2, 3, 4, & 8, without, however, any specific definition thereof in these claims;—the grease-cup or "nipple" being defined in the claims merely in broad and all-inclusive terms not distinguishing from the grease-cups or "nipples" of the prior art.

Plaintiff-respondent's theory of infringement (levelled at defendant-petitioner's old and unpatented grease-cup), in the *Rogers vs Alemite* case was that

In the Case at Bar:

plaintiff-respondent's own allegedly* Butler-improved couplers (and an old pump) is applied momentarily to defendant-petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing", then, during each momentary application of one of plaintiff's - respondent's allegedly* Butler - improved couplers (and an old pump), the entire **assemblage** of the several distinct devices defined in Butler claim 2 comes into being, and that the old grease-cup in such momentary **assemblage** is a device not made or sold by respondent, but indeed, made and sold by petitioner. This, according to respondent's theory of the case, constitutes **contributory** infringe-

In the Rogers vs Alemite Case:

when one of respondent's own Gullborg-improved couplers (and an old pump) were applied momentarily to defendant - petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing", then, during each momentary application of one of plaintiff - respondent's Gullborg-improved couplers (and an old pump), the entire **assemblage** of the several distinct devices defined in Gullborg claims 1, 2, 3, 4, & 8 would come into being, and that the old grease-cup in such **assemblage** would be a device not made or sold by respondent, but indeed, made and sold by petitioner. This, according to respondent's theory of the case, constituted **contributory** in-

* See explanation immediately following these parallel columns.

In the Case at Bar:

ment on the part of petitioner;—the direct infringement taking place the few moments respondent's *allegedly** Butler-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.

In the Rogers vs Alemite Case:

fringement on the part of petitioner;—the direct infringement taking place the few moments respondent's Gullborg-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.

The only difference between the case at bar and the Rogers v. Alemite case is that while the Gullborg coupler improvement was in reality embodied by plaintiff in its commercial coupler device which it at once sold in substantial quantities, the couplers made by respondent allegedly embodying the Butler coupler improvement, are in fact not even made in accordance with the Butler patent and do not embody the Butler coupler improvement. This difference does not help respondent's position in the case at bar, but on the contrary, further detracts from it.

Respondent strenuously but unsuccessfully urged before the Court of Appeals for the 8th Circuit, in Stewart-Warner v. Jiffy (81 Fed 2d 786), that its commercial couplers, marketed under the trade designation of "Alemite Hydraulic" couplers, were in accordance with the Butler patent and within the scope of the claim thereof. The Court of Appeals for the 8th Circuit, however, in Stewart-Warner v. Jiffy (certiorari denied, 299 U. S. 554), held that respondent's own *allegedly* Butler-improved couplers were not

* See explanation immediately following these parallel columns.

Butler improved at all, as they were **not** in accordance with the Butler patent here in suit and were **not** within the scope of the claim thereof. The decision of the Court of Appeals for the 7th Circuit in the case at bar is therefore in direct conflict with the correct decision of the Court of Appeals for the 8th Circuit in the case of *Stewart-Warner v. Jiffy* (certiorari denied, 299 U. S. 554), as to the scope of the coupler-part of the Butler patent here in suit.

The Court of Appeals for the Seventh Circuit in its decision in the case at bar (91 Fed 2d 757) recognized the applicability of this Court's earlier decision in the *Rogers v. Alemite* case to the case at bar with respect to the first of the three grounds of appeal there presented to that Court by petitioner. Thus, the Court of Appeals for the Seventh Circuit in its opinion in the case at bar said (at p. 760):

"Appellant challenges the decree on three separate, distinct grounds, stating each with commendable frankness, brevity, and clarity:

"(1) Butler's hose coupler can not be validly claimed in combination with a non-patented lubricant receiving nipple or an old compressor, particularly where his conceded purpose is not merely to monopolize the hose coupler, but to include in the monopoly the admittedly old device which is used with it. To support this position appellant relies upon *Bassick Manufacturing Co. v. Hollingshead Co.* and *Rogers v. Alemite Corp.*, 298 U. S. 415.

"(2) The coupler of the Butler patent shown in Figure 2 is not the so-called "Alemite Hydraulic" coupler. Supporting this position, appellant relies upon the facts brought out by the evidence and the holding in *Stewart-Warner v. Jiffy Lubricating Co.*, 81 Fed 2d 786.

"(3) The Butler multi-jaw chuck type hose coupler is not a patentable improvement over the multi-type hose coupler of the prior art. As bearing upon this issue, it contends that the evidence does not support the finding of validity because the Butler hose coupler as described by Butler both in Figure 2 and in his claim never went into commercial use. It likewise argues that extensive use where the trade was so dominated by Stewart-Warner is not persuasive of validity.

"The importance of the suit and the effect of the Bassick opinion upon the whole field of patent law make it impossible for us to dispose of the case in an opinion of desirable and satisfactory brevity.

"While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that *Bassick v. Hollingshead, supra*, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court (in Pennsylvania) in *Stewart-Warner v. Universal Co.*, 15 F. Supp. 410.

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the *Bassick v. Hollingshead* opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

• • • • •

"The novel proposition which appellant seeks to apply to the present case is to be found in the language on pages 424, 425. There it was said:

“ ‘It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler and a grease cup or pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) *The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.*’ That this cannot be done is shown by numerous cases in this and other federal courts.’ ”

What the Court of Appeals for the Seventh Circuit in the case at bar has **erroneously** characterized as “the novel proposition” is seemingly that part of this Court’s opinion in the Rogers v. Alemite case which the Court of Appeals for the Seventh Circuit emphasized by italics in quoting from this Court’s opinion as last above shown;—that emphasis having been supplied by the Court of Appeals in its own quotation from this Court’s opinion.

At the outset, respondent admitted in its brief addressed to the Court of Appeals for the Seventh Circuit

*Emphasis by the Circuit Court of Appeals.

in the case at bar, that if the first issue presented to that Court by defendant-petitioner was correctly stated, that then "there can be only one answer,—the answer which defendant wants".

Thus, the first issue presented by us to the Court of Appeals for the Seventh Circuit in the case at bar was:

"Can an improvement in a hose coupler be the basis for a valid monopoly on an old headed nipple or an old compressor which is to be used with it?"

The Circuit Court of Appeals conceded the correctness of petitioner's statement of said first issue, which, even according to respondent, could be answered only favorably to petitioner. Notwithstanding this, however, the Circuit Court of Appeals answered said issue unfavorably to petitioner.

Petitioner respectfully submits that this Court's opinion in the *Bassick v. Hollingshead* and *Rogers v. Alemite*, 298 U. S. 415, is correct and controlling on this point of law at bar.

Thus,

while respondent has conceded on page 3 of its main brief addressed to the Court of Appeals for the Seventh Circuit in the case at bar that on the first issue there presented (here argument point No. 2) "there can be only one answer,—the answer which defendant (petitioner) wants", and

while the Court of Appeals for the Seventh Circuit could find no fault with our statement of issue No. 1 there presented by us (present argument point No. 2) but instead commended us for the frankness, brevity and clarity of our statement of the issue,

the Court of Appeals for the Seventh Circuit nevertheless decided against petitioner and contrary to and in conflict with this Court's recent ruling and decision on a precisely parallel factual situation and the same question of law (298 U. S. 415).

We respectfully submit that the decision of the Court of Appeals for the Seventh Circuit in the case at bar on this second point is manifestly erroneous and in conflict with the decision of this Court in the *Rogers v. Alemite* case and other decision of this and other Federal Courts and should be reversed by this Court.

ARGUMENT OF POINT III.

Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease-cup, pump and coupler;—whereas patentee's improvement, if any, is merely in the assertedly improved coupler.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously held, in effect, that one who invents an improvement in **one** device normally useful in conjunction (or in an old combination) with **other** devices of the prior-art, need not content himself with merely claiming his assertedly improved device, per se, but may validly claim his improved device *in the old combination* where it is normally to be used.

The aforesaid decision of the Court of Appeals for the Seventh Circuit in the case at bar is clearly in conflict with the applicable decisions of this Court and other appellate courts, as shown by the following decisions:—

Heald v. Rice, 104 U. S. 737, 755;

Underwood v. Gerber, 149 U. S. 224, 227;

General Electric Co. v. Ohio Brass Co., 277 Fed 917 (C. C. A. 3);

Langen v. Warren Axe & Tool Co., 184 Fed 720 (C. C. A. 3);

In re Ratican, 36 App. D. C. 95;

In re Germantown Trust Co., 57 Fed 2d 365 (U. S. Ct. of Customs & Patent Appeals);

Kodell Electric v. Warren Telechron, 62 Fed 2d 692 (C. C. A. 6);

Alemite Corp. v. Lubrair Corp., 62 Fed 2d 899 (C. C. A. 1);

Rogers v. Alemite
Bassick v. Hollingshead } 298 U. S. 415.

The first four of the above cited cases were cited by this Court in its recent decision in *Rogers v. Alemite and Bassick v. Hollingshead* (298 U. S. 415).

Section 4888 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 33) not only requires the applicant for a patent to make a full and clear disclosure of his alleged invention, but also further requires that "he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

It is because of this statutory requirement that each patent contains (or that the specification of each patent concludes with) one or more claims.

However prolix the patentee may have been in describing his invention in the specification of his patent, he should, at least in his claims, clearly delineate between that which he really invented and that which he did not invent (or that which was in the public domain).

Thus, however loosely a patentee may describe* his invention in relation to the prior-art to which it relates, nevertheless in the claim or claims of his patent, he must *not* commingle that which he invented, with that which is in the public domain. Otherwise, the statutory requirement for claims is completely vitiated. Unless this statutory requirement is complied with, the public has no possible way of knowing where the patentee's contribution begins and where it ends.

In the case at bar, just as in the case of Gullborg claims 1, 2, 3, 4 and 8, adjudicated by this Court (at 298 U. S. 415), the patentee's contribution, if any, was in an assertedly improved coupler. That is where the patentee's contribution ends, however. There was no further invention involved in the mere idea of using the assertedly improved coupler in a way that couplers had always been used, that is, in conjunction with the other two old devices (grease-cup and pump) requiring to be coupled, or needing a coupler.

Respondent's misconceived theory of patent-claiming in the case at bar, is merely that if the coupler is new, then, as a matter of form, the coupler plus old grease-cup plus old pump is also "new".

Precisely that was the situation in the case of Gullborg claims 1, 2, 3, 4 and 8 involved in *Rogers v. Alemite* (298 U. S. 415).

Gullborg even went so far in some of the claims as to include, as an element of the claimed "combination", the machinery such as the automobile requiring to be lubricated. Thus, for instance, Gullborg claim 8 adjudicated by this Court not only included in the so-called "combination"

*In the descriptive portion of his specification.

(with the assertedly improved coupler) the admittedly old pump, hose and grease-cup, but also included the "apparatus having a part to be lubricated"—this last phrase generically defining (in the *claim*) the automobile or other machine to which the grease-cup may be attached.

Thus, according to respondent's misconceived theory of patent-claiming, anyone inventing a better or improved coupler may claim in so-called "combination" therewith, the old pump and old grease-cup;—merely because the old pump and old grease-cup are to constitute the environment in which the improved coupler is to be used. It is respondent's theory therefore that if the coupler is new, then naturally the *combination* with it of an old pump and old grease-cup must, as a matter of course, also be new.

The fallacy of this theory of patent-claiming has been exposed many times in the decisions hereinabove cited on pages 78-9. The fallacy of this theory of patent claiming will further be apparent when it is recognized that by far the largest bulk of all mechanical devices now in common use (both old and new) are not useful alone, but only when used in conjunction (or in so-called "*combination*") with other devices.

Thus, an improved bottle-cap-opener is not useful by itself but only when used in conjunction (or in so-called "*combination*") with an old bottle and an old bottle-cap. It will be conceded that there is co-action and cooperation between the bottle-cap-opener, on one hand, and the bottle-cap and bottle, on the other hand;—indeed they all work together when the bottle-cap-opener is in actual operation. It will also be conceded that an improved bottle-cap-opener may grip or grab the bottle-cap better than some other unimproved bottle-cap-opener.

Likewise, an improved lamp-socket undoubtedly co-operates and co-acts with the old electric bulb which it is adapted to receive, and may indeed hold the electric bulb better and make better electrical contact with it than some other unimproved electric socket.

Likewise, an improved quick-detachable and quick-attachable coupler for connecting the old fire-engine to the old fire-hydrant at the street curb or with the old stand-pipe (on the side of the skyscraper) co-acts with and co-operates with the fire-engine and the fire-hydrant, and may indeed make a much better coupling between the old fire-engine and the old fire-hydrant than that made by some other unimproved coupler.

So, whenever any single device is improved, can it be said that the patentee also invented the "*combination*" therewith of the old devices with which it is to be used? Obviously not.

As pointed out by this Court in *Heald v. Rice* (104 U. S. 737, 755), the inventor of an assertedly improved return-flue boiler for use with an old straw-feeding device, did not invent a new *combination* of boiler plus straw-feeding device. He merely invented a new return-flue boiler (if anything). The claim on the so-called "*combination*" of boiler and straw-feeding device was therefore held invalid.

Likewise, an improved coating composition may constitute a patentable improvement. As pointed out however by this Court in *Underwood v. Gerber* (149 U. S. 224, 227), there is no further invention involved in the idea of coating the improved coating composition onto a sheet of paper, as coating compositions had always been combined with paper.

Or, as pointed out by the Court of Appeals for the Third Circuit in *General Electric v. Ohio Brass* (277 Fed

917), while there may be patentable invention in an improved electrical insulator, there is no invention in the idea of combining the improved insulator with the old poles and cross arms and electrical wires with which other old and unimproved insulators had customarily been used.

So in the case at bar, there was no patentable or inventive concept involved in putting an assertedly improved coupler to use in conjunction with the old grease-cup and old pump;—irrespective of whether the coupler itself may be an improved and patentable coupler.

For this reason, the Butler claim is **invalid** as drawn to an old and exhausted combination of grease-cup, pump and coupler, whereas Butler's invention, if any, was merely in the internal construction or mechanism of the coupler (that is, the *combination of coupler-composing elements*).

The Butler claim in suit therefore violates Section 4888 of the Revised Statutes, 35 U. S. Code 33, in that the patentee has **commingled** in his claim that which at best was his contribution and that which was clearly and most obviously within the public domain (the old grease-cup and old pump). The decision of the Circuit Court of Appeals in the case at bar should therefore be reversed by this Court.

ARGUMENT OF POINT IV.

Point IV-a:

Section 3 of the Clayton Act prohibits the monopoly herein asserted by respondent and erroneously sustained by the Court of Appeals.

Respondent may **NOT** restrict the proper and only possible use of the assertedly Butler-improved couplers of its own manufacture, to the use of such couplers solely with grease-cups of its own manufacture and to the exclusion of grease-cups manufactured and sold by petitioner;—not

withstanding respondent's ownership of a patent assertedly covering its coupler in so-called "combination", broadly, with any old grease-cup,

or, otherwise stated:

Respondent may NOT impose as a condition of sale of its assertedly Butler-improved couplers, that the purchasers shall not use the same in conjunction with old-style grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved coupler in so-called combination with an old-style grease-cup. Such condition of sale is violative of Section 3 of the Clayton Act.

Point IV-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-improved "Alemite Hydraulic" couplers are impliedly licensed to use the same with any old and unpatented grease-cups including those of petitioner.

While the courts have from time to time approached the problem of improper "combination" claims through several different avenues of approach, the result has always been the same, to wit, the denial of the patent owner's asserted monopoly of old and unpatentable devices.

In foregoing **Argument of Point II**, we have pointed out this Court's treatment of precisely the same problem in the case of *Rogers v. Alemite* (298 U. S. 415).

In *Rogers v. Alemite*, where the defendant-petitioner had conceded the validity of the patent in the trial court,* this Court solved the problem of improper "combination" claims upon the broad proposition that a patentee could

*In reliance upon the broader defense rejected by both lower courts in that case but sustained by this Court at 298 U. S. 415.

not re-patent the old combination of grease-cup, pump and coupler (regardless of the presence of some asserted improvement in the coupler), and could not so re-monopolize the old grease-cup.

In support of its decision, this Court cited a number of earlier decisions of its own and also other Federal Courts. The decisions cited by this Court in support of its decision in *Rogers v. Alemite* may be classified into three groups according to the manner in which the Court approached and solved the problem of improper "*combination*" claims involved in the particular case.

Thus, some of the authorities cited by this Court in its opinion in *Rogers v. Alemite* hold that such improper "*combination*" claims are **invalid** as drawn to an old and exhausted combination, whereas the asserted improvement, if any, is merely in the construction of one of the elements:

Heald v. Rice, 104, U. S. 737, 755;

Underwood v. Gerber, 149 U. S. 224, 227;

Langen v. Warren Axe & Tool Co., 184 Fed 720;

Troy Wagon v. Ohio Trailer, 274 Fed 612;

General Electric v. Ohio Brass, 277 Fed 917

(C. C. A. 3);

Wall Pump Co. v. Gardner, 28 Fed 2d 334, 338

(C. C. A. 7).

The general point of law upon which the last above-cited decisions rest, constitutes our **Argument of Point III**; wherein we have relied upon these decisions and others covering the same point of law, to the effect that when one invents the asserted improvement in one device he may claim the combination of elements constituting that one device, but may not claim the so-called "*combination*" of that one (assertedly improved) device with other old devices with which it is normally used.

The following authorities cited by this Court in its opinion in *Rogers v. Alemite*, 298 U. S. 415, hold that so-called "combination" claims which claim an assertedly improved device in so-called "combination" with one or more old devices (with which the improved device must be used) cannot be asserted either through a patent infringement suit or through patent license contracts (with licensees under the patent) to prevent or restrict the use of the old and unpatented devices manufactured by others:

Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 431, 432;

Carbice v. American Patents Corp., 283 U. S. 27, 31, 32;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed. 564;

Radio Corp. v. Lord, 28 Fed 2d 257.

On the other hand, the case of *Edison Electric Light Co. v. Peninsular Light Co.*, 101 Fed. 831 (C. C. A. 6) cited by this Court in its opinion in *Rogers v. Alemite*, solves the problem of so-called "combination" claims by holding that the purchaser of the inventive device (from the patentee), has an implied license to use with it the old and uninventive devices purchased from others;—notwithstanding the fact that such old and uninventive devices are included generically in the patent claim

The last two groups of authorities, and others on the same points of law are relied upon as authorities for **Argument of Point IV**, parts a and b respectively.

Whether the controversy arises as a patent infringement suit, as in the cases of

Morgan Envelope v. Albany Paper, 152 U. S. 425, 431, 432;

Carbice v. American Patents Development Corp.,
283 U. S. 27;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed 564;

or whether it arises under a patent contract as in the cases
of

United Shoe Mach. Corp. v. U. S., 258 U. S. 451;

Radio Corp. v. Lord, 28 Fed 2d 257 (C. C. A. 3);
(Certiorari denied, 278 U. S. 648);

International Business Machines Corp. v. U. S.,
298 U. S. 131;

the courts have uniformly held that competitive sale of the old and unpatented devices or articles of commerce which may be generically included in the claims of a patent (in conjunction with some *other* device presumably invented by the patentee) may not be prohibited or restricted or in any way curtailed.

The courts have so held regardless of whether the prohibition, restriction or curtailment was attempted to be worked through the assertion of the patent against such competitive old devices under the theory of "contributory" infringement, as in the first group of cases last above cited, or whether such prohibition, restriction or curtailment was attempted to be worked through a license contract or other contract with licensees or users under the patent in question, as in the second group of cases last above cited.

Thus, there is no conflict whatever between the patent laws and the anti-trust laws. On the contrary, the patent laws were not intended to grant monopolies on old and unpatented devices or articles of commerce, and the anti-trust laws expressly prohibit such monopolies.

In the case at bar, the Court of Appeals for the Seventh Circuit has erroneously sustained respondent's asserted monopoly of admittedly old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings." Such monopoly was not contemplated by the patent laws and is expressly prohibited by the anti-trust of the United States. Therefore, for this further reason, the decision for the Circuit Court of Appeals for the Seventh Circuit in the case at bar should be reversed by this Court.

The problem of improper "combination" claims was dealt with in the following cases under the principle of implied license by estoppel:

Edison Electric Light Co. v. Peninsular Light,
Power & Heat Co., 101 Fed. 831 (C. C. A. 6);
Thomson-Houston Electric Co. v. Illinois Tele-
phone Construction Co., 152 Fed 631 (C. C. A.
7).

Thus, in these cases, the Court, in an effort to save the patentee from the consequences of the improper form of his patent claims, held that the defendant had an implied license to manufacture and sell and use the old and unpatentable devices of the prior-art, which were generically included in the patent claim. This was on the theory that when the patentee sold the inventive devices without restriction or limitation, he impliedly granted to the purchaser of such inventive device the license to use the same with the old and unpatentable devices of the prior art with which it had to be used in order to have utility.

Thus, in the case at bar, respondent sold its assertedly Butler-improved couplers and the old pumps without restriction or limitation, and the purchasers of such assertedly Butler-improved couplers and old pumps (of respondent's

manufacture) necessarily have the implied license to use such devices in the only way they were intended to be used and the only way in which they could be used; that is, in conjunction with the old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings." The purchasers from respondent (of its assertedly Butler-improved couplers and old pumps) having such an implied license, it necessarily follows that any member of the public, including petitioner, has a right to supply such old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings" for use with the assertedly Butler-improved couplers and old pumps purchased from respondent.

The decision of the Court of Appeals for the Seventh Circuit is therefore clearly erroneous and in conflict with this last cited line of authorities and should for that reason also, be reversed by this Court.

CONCLUSION.

In conclusion, it is respectfully submitted that the decision and judgment of the Court of Appeals for the Seventh Circuit should be reversed by this Court, for the reason that said decision and judgment of the Circuit Court of Appeals for the Seventh Circuit

is in direct conflict with the correct decision of the Circuit Court of Appeals for the Eighth Circuit as to the scope of the coupler-part of the same patent (Stewart-Warner v. Jiffy, 81 Fed 2d 786, certiorari denied 299 U. S. 554);

is in direct conflict with the correct decision of this Court in the case of Rogers v. Alemite, 298 U. S. 415, as to another patent just like the patent here in suit and presenting precisely parallel facts and the same legal situation;

is in direct conflict with the correct decision of the United States District Court for the Western District of Pennsylvania, for the defendants, in a suit on the same patent as in the case at bar, on the authority of this Court's decision in said Rogers v. Alemite case (Stewart-Warner v. Rogers & Universal, 15 F. Supp. 410);

is in direct conflict with the earlier correct decisions of this and other Federal Courts on the point of law that a claim drawn to an old and exhausted combination of several separate and distinct devices (customarily used with each other) is invalid where the patentee's improvement is merely in the construction or mechanism of one of the several devices;

is in direct conflict with the earlier correct decisions of this and other Federal Courts on the point of law that the patent owner who has manufactured and sold an assertedly improved and patentable device (a coupler) may not prohibit or restrict the use thereof by reason of his ownership of a patent covering his improved device (coupler) in so-called "combination" with other old and unpatentable devices or articles of commerce with which it is normally to be used; or otherwise stated, the owner of a patent on a so-called "combination" of several separate and distinct devices or articles of commerce may not impose, as a condition of the sale of his assertedly improved device, that the same shall not be used in conjunction with the other old devices of a competitor;

is in direct conflict with the earlier correct decisions of another Circuit Court of Appeals (and also the

earlier decision of the same Circuit Court of Appeals) on the point of law that when the patentee sells his assertedly improved device without restriction, the purchaser acquires an implied license to use it with the other old and unpatentable devices with which it normally must be used in order to have utility, and under such implied license, any member of the public has a right to supply such old and unpatentable device or article of commerce.

Respectfully submitted,

LINCOLN ENGINEERING CO. OF ILLINOIS,

Petitioner,

By LEONARD L. KALISH,

DELOS G. HAYNES,

LLOYD R. KOENIG,

Counsel for Petitioner.

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APPENDIX I.

The following excerpts from plaintiff-respondent's briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) further show just what respondent did urge upon and admit to that Court as to the scope of the Butler patent. (emphasis supplied.)

Respondent urged in its Jiffy suit

(on page 3 of its main brief in CCA 8):—

"Lubricating equipment manufactured by the present plaintiff, Stewart-Warner Corporation, and first manufactured by its subsidiary, Alemite Corporation, and marketed under the name 'Alemite Hydraulic Type Lubricating Equipment,' immediately upon its commercial introduction displaced all other types of lubricating equipment on automobiles. This Alemite hydraulic type of equipment embodies the invention of this Butler patent. The language of claim 1 describes it with literal fidelity."

Respondent urged in its Jiffy suit

(on page 5 of its main brief in CCA 8):—

"The tremendous success of the plaintiff's Alemite hydraulic type of lubricating equipment is emphasized by the sales figures of Plaintiff's Exhibit No. 8, Rec. 345. These figures show that in the single year of 1934 the sales of plaintiff's hydraulic type of equipment amounted to two and one-quarter million dollars. The tremendous commercial success of this hydraulic type of equipment is due solely to the advantages resulting from Butler's invention."

Respondent urged in its Jiffy suit

(on page 6 of its main brief in CCA 8):—

"The plaintiff's hydraulic type of equipment is protected by this Butler patent only if claim 1 be given its

natural and literal meaning. The Alemite hydraulic equipment responds to the literal wording of claim 1 of Butler (Rec., 98-99), but **this hydraulic equipment does not have spring fingers and is not protected by this claim with the additional limitation read into it by the District Court.**"

Respondent urged in its Jiffy suit

(on page 11 of its main brief in CCA 8):—

"This variation of Butler's Figure 2 has been adopted by **both** the plaintiff's Alemite hydraulic type of coupler and the defendant's Jiffy coupler."

Respondent urged in its Jiffy suit

(on page 12 of its main brief in CCA 8):—

"Claim 1 of the Butler patent reads on this Alemite hydraulic type of equipment just as clearly as it does on the disclosure of the Butler patent."

Respondent urged in its Jiffy suit

(on page 14 of its main brief in CCA 8):—

"The Commercial Success of the Alemite Hydraulic Type of Equipment Embodying the Invention of the Butler Patent Was Due to the Advantages Inherent in Butler's Invention.

"We have already pointed out that by 1930 all American-made passenger automobiles and trucks were factory-equipped with either the Alemite pin type of lubricating equipment made under Gullborg patent 1,307,734, or the Alemite push type of lubricating equipment made under Zerk patent 1,475,980, and that all passenger automobiles and trucks made in America continued to have one or the other of these systems as factory equipment until the introduction of the Alemite hydraulic type of equipment in April, 1933. By January, 1934, all American-made automobiles, including both passenger vehicles and trucks, had changed over to the Alemite hydraulic type of lubricating equipment. (Rec., 66.)

"The rapid adoption of the **Alemite hydraulic** type of lubricating equipment by the automobile manufacturers was based on certain important **advantages** which this equipment has over the Gullborg and Zerk equipments previously used. These advantages are an **inherent part of Butler's invention.**"

Respondent urged in its Jiffy suit

(on page 2 of its reply brief in CCCA 8):—

"(4) If claim 1 of the Butler patent be given merely the plain and natural meaning of its words, then it describes both (a) the "**Alemite Hydraulic**" lubricating equipment sold by the plaintiff, and (b) the '**Jiffy**' lubricating equipment sold by the defendant.

"(5) Within less than one year after its advent upon the market, the plaintiff's '**Alemite Hydraulic**' lubricating system had completely displaced every other known means for lubricating the chassis bearings of automobiles,—to the extent that every automobile and truck manufactured in America was equipped at its factory with the '**Alemite Hydraulic**' equipment. That condition has continued uninterruptedly to the date of the trial herein.

"(6) Even if claim 1 of the Butler patent be interpreted to mean the precise thing described and illustrated in Butler's specifications and drawings, still, if Butler is entitled to any range of '**equivalents**' whatsoever, then (a) the plaintiff's '**Alemite Hydraulic**' equipment embodies the Butler invention, and (b) the defendant has infringed."

Respondent urged in its Jiffy suit

(on page 11 of its reply brief in CCA 8):—

"Even here, however, the language of claim 1 does not support the twist which counsel attempt to give to it. What counsel for defendant-appellee attempt to make of this language is a statement that the piston must directly and immediately compress the locking jaws. They attempt to **distinguish this fanciful limitation from a construction**

like that of the Alemite Hydraulic system and the defendant's system, in which the actuation of the piston more indirectly compresses the locking jaws about the nipple for locking the parts together."

APPENDIX II.

The following admissions from pages 49 to 54 of the transcript of respondent's oral argument before the Court of Appeals for the Seventh Circuit in the case at bar (reported by court stenographer Rankin) further confirms the fact that the Court of Appeals for the Seventh Circuit in the case at bar **did** reach a conclusion as to the scope of the Butler patent, in conflict with the conclusion reached by the Court of Appeals for the Eighth Circuit as to the scope of the same patent:

.
"MR. WILLIAMS: . . . Now, there again I probably have not spent enough time on it to make absolutely clear all of the details of the construction, but I have gone into it with the idea of convincing your Honors, if I may, that the difference between the plaintiff's commercial construction and the disclosure of the patent involves the simplest kind of a mechanical reversal and equivalency.

JUDGE EVANS: What does the defendant sell?

MR. WILLIAMS: Beg pardon?

JUDGE EVANS: What does the defendant sell?

MR. WILLIAMS: What the defendant sells is this nipple part.

JUDGE EVANS: You don't make any claim that he sells the other part?

MR. WILLIAMS: That is right. Now, what defendant discloses is a piston—this is of course an enlarged model—piston acted upon by the grease with a wedging or camming surface at the forward end. In the shell of the coupler there are mounted some jaws and there is a piece of sponge rubber between those jaws. The result is that the grease pressure comes on as I shall simulate, those jaws are squeezed inwardly—I don't know whether your Honors can see that—squeezed inwardly, and it is the inward movement of

those jaws which grip about the neck of the nipple and hold the parts together during the injection of the grease.

Now, what the plaintiff has done in its commercial model is to reverse those jaws, and your Honors will see at the forward end of this enlarged coupler the ends of three jaws corresponding somewhat with the three jaws as they appear in this aluminum model. That has been turned; instead of that way it has been turned this way, and the part of the piston which formerly acted as the wedging cam has been incorporated into the outer shell here and the forward end of the piston in this instance has been left square like that. Now, your Honors will observe the three jaws and you will see again that they are squeezed inwardly in such a way as to grab about the neck of the fitting. There is that simple reversal, and that is one of the grounds which is urged by the defendant for saying that the parts which we sell do not embody the disclosure of the Butler patent and do not embody the claim of the Butler patent, although your Honors will find that the language of the claim is just as readable upon this reversed form as it is upon the other. Just because of that reversal the contention is made that we ourselves have not embodied the Butler patent in the thing that we sell and from that the argument is made that if the defendant sells a part of that combination it cannot contributorily infringe because we ourselves are not supplying other parts necessary to complete the infringement. Now, I want to skip to—

JUDGE EVANS: Starting with that last, that position is sound, is it not, if you were not selling a product that is the embodiment of a patent?

MR. WILLIAMS: That would be conclusive. If what we sell does not embody, so far as this goes, the Butler invention, then nothing that the defendant could do with the balance of the stuff would be contributory infringement;—but that, of course, is what we do sell.

JUDGE EVANS: The point of that is that the Eighth Circuit has held that this does not embody.

MR. WILLIAMS: Well, that is one of the things that counsel says and with which I disagree to this extent. In the Eighth Circuit Court of Appeals we had brought a suit against a concern which was engaged in, not making a gun as counsel says, but in making a coupler with a gun or compressor and the fitting part too and we brought suit against that Jiffy Company alleging infringement by its sale of the entire thing, and as showing the extent to which the Butler invention was gone into at that time, we offered evidence showing that the plaintiff had sold, as it has literally, millions and millions of guns and couplers and literally hundreds of millions of the fitting parts, and the Court of Appeals for the Eighth Circuit said, and that is a matter that I want to come to, said that as they viewed the Butler patent, it must be strictly limited to certain spring fingers so flimsy that there would be no effective gripping such as I have demonstrated by the coupler and the nipple, and that the plaintiff in its construction had effected the kind of a reversal that I have been showing to your Honors, and furthermore, that this construction was such that there was a powerful gripping, and they said that that was not the disclosure of the Butler patent and therefore they would not give the Butler patent the breadth or the scope requisite to hold the defendant, because it was not shown to have been a commercial success, that one claim.

JUDGE EVANS: This is what your opponent said, that they held that this was not entitled to that scope and also held that the coupler was originally copied from Jiffy, that they had made that very thing, and therefore you were necessarily—

MR. WILLIAMS: I don't remember exactly what they said about that.

JUDGE EVANS: Your position is practically that we must reject that decision as to the scope of that patent.

MR. WILLIAMS: It was not strictly an issue in this case, and to the extent that the Eighth Circuit Court of Appeals

said what they did upon the scope, I am urging your Honor to disagree. I say it was no ultimate issue in that case. It was a discussion of collateral evidence that might have swayed the Court on a question of invention, and trying to apply the facts, they reached the conclusion with which I do not agree upon that point. I am asking your Honors therefore, if not to disagree with them, at least to reach a different conclusion."

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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

No. 608.

October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

v.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

Petitioner's Reply Brief.

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